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No. 1901 36

In the Supreme Court of the United States.

OCTOBER TERM, 1901.

CLINTON E. WORDEN & CO.,

Appellants,

vs.

CALIFORNIA FIG SYRUP COMPANY,

Appellee.

Can the words "Syrup of Figs" be appropriated as a trademark for a laxative medicine, containing but an infinitesimal quantity of fig juice, which gives no effect to the medicine either medicinally or otherwise, and which is used merely to trade on the popular fallacy that figs are laxative?

Brief on Behalf of Appellant.

JOHN H. MILLER,
PURCELL ROWE,
For Appellants.

PRIOR ADJUDICATIONS

On the Trade-Mark Syrup of Figs.

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1. Cal. Fig Syrup Co. *vs.* Imp. Fig Syrup Co. ..... 51 Fed., 296
2. Imp. Fig Syrup Co. *vs.* Cal. Fig Syrup Co. ..... 54 " 175
3. Cal. Fig Syrup Co. *vs.* Putnam..... 66 " 750
4. Cal. Fig Syrup Co. *vs.* Stearns..... 67 " 1008
5. Cal. Fig Syrup Co. *vs.* Putnam..... 69 " 741
6. Cal. Fig Syrup Co. *vs.* Stearns..... 73 " 813
7. Cal. Fig Syrup Co. *vs.* Worden..... 86 " 212
8. Cal. Fig Syrup Co. *vs.* Worden..... 95 " 132
9. Worden *vs.* Cal. Fig Syrup Co.....102 " 334

No. 192.

In the Supreme Court of the United States.

OCTOBER TERM, 1901.

CLINTON E. WORDEN & CO.,
APPELLANT AND PETITIONER,

vs.

CALIFORNIA FIG SYRUP COMPANY,
APPELLEE.

Brief for Petitioner.

This case has been brought here by writ of *certiorari*. It was instituted by the California Fig Syrup Company against Clinton E. Worden & Co. in the Circuit Court of the United States for the Northern District of California. Its object was to restrain the infringement of a common law trade-mark consisting of the words "Syrup of Figs" or "Fig Syrup," as applied to a liquid laxative medicine, and also to enjoin unfair competition in trade by reason of the use of alleged simulated labels and wrappers.

The bill charged that in 1879 one Richard E. Queen, of Reno, Nevada, "invented" the medicine in question and adopted as a trade-mark therefor the words "Syrup of Figs" or "Fig Syrup," by which name the medicine became known, and also that he put up the medicine in a certain style of bottle and wrapped it with a certain label which gave it a distinctive appearance.

This trade-mark, together with the label and good will of the business, Mr. Queen sold to the appellee, a corporation created under the laws of California, which corporation has ever since been selling the medicine.

The usual charge of infringement was made, asserting that the appellant had sold a similar medicine of inferior composition under the same name and put up in bottles and dressed in labels and wrappers so closely resembling those of the appellee as to deceive the public.

The prayer of the bill was for an injunction to restrain the appellant from infringing upon the trade-mark proper and also from unfair competition in trade by reason of simulated labels.

The appellee based its cause of action solely upon its common law rights, no registration of any kind being alleged or relied on, and the ground of jurisdiction was diverse citizenship of the parties.

A preliminary injunction was granted in the case by

the circuit court (Judge Morrow presiding), and is reported in 86 Federal Reporter at page 212, *et seq.* This injunction was granted solely on the ground of unfair competition in trade by reason of simulated labels and wrappers and not on the ground of infringement of the trade-mark proper. In rendering its decision thereon the court said:

"The bill of complaint in this case proceeds upon the theory that the rights of the complainant have been infringed by the defendant by unfair competition. It is not strictly a charge of infringement of a trade-mark, although it has many of the elements of such a case; but the facts alleged by the complainant are plainly set forth for the purpose of establishing the charge that the defendants are engaged in an unfair and fraudulent competition against the business of the complainant, conducted with the intent on the part of the defendants to avail themselves of the reputation of the defendants to palm off their goods as the goods prepared and put up by the complainant. The main question is, therefore, one of fact, since the law on the subject has been settled by numerous authorities."

California Fig Syrup Co. vs. *Clinton E. Worden & Co.*, 86 Fed. Rep., 215.

Thereafter on final hearing the circuit court entered its decree in favor of the appellee, whereby it enjoined the appellant broadly from using the words "Syrup of

Figs" and "Fig Syrup" as a trade-mark, and also from unfair competition in trade by reason of simulated labels and wrappers. This decree will be found at page 579 of the record, and the opinion of the court rendered thereon at page 574. The case on final hearing is reported in 95 Fed. Rep., 132. There is a conflict between the opinion of the court and the decree itself. By the opinion it will be seen that the court did not pass upon the question of trade-mark, but contented itself with holding that the defendant in the case was guilty of unfair competition in trade by reason of simulated labels and wrappers. The syllabus of the case says:

"The California Fig Syrup Company is entitled to protection from unfair competition in its business in the production and sale as a medicine of a compound known as "Syrup of Figs" *irrespective of any question of trade-mark*, and to an injunction against the production and sale of a similar article put up in such form that it can be sold to an ordinary purchaser as the preparation of said company."

The decree itself, however, goes beyond this opinion, and not only enjoins the use of simulated labels and wrappers, but likewise enjoins the use generally of the words "Syrup of Figs" and "Fig Syrup" as a trade-mark, without regard to the character or appearance of the label itself.

From this decree an appeal was prosecuted by the appellant to the circuit court of appeals for the ninth circuit, where the decree was affirmed by the votes of two of the judges, Honorables W. B. Gilbert and Thomas P. Hawley, against the dissent of the third judge constituting the court, Honorable Erskine M. Ross. The decree of the court of appeals will be found at page 645 and the opinion at pages 637 *et seq.* of the record.

Clinton W. Worden & Co. vs. California Fig Syrup Co., 102 Fed. Rep., 338.

Upon application made to this court at the October term, 1900, the writ of *certiorari* was granted on the ground of conflict of decision between different circuit courts of appeal, and the case is now before the court for hearing upon said writ.

The fundamental question to be determined by this court is, can the words "Syrup of Figs" or Fig Syrup' be lawfully appropriated as a trade-mark pure and simple under the facts disclosed by the record?

The question of simulated labels and wrappers is one of minor importance. If the appellant is guilty of any wrongdoing in that regard, it can and will willingly remedy it by changing the form of its labels and wrappers. But if the words "Syrup of Figs" or "Fig Syrup"

constitute a valid trade-mark, without regard to the form of the labels and wrappers, then the appellant will be precluded from the sale of the medicine under that name, whatever may be the form of its labels and wrappers, and thereby it will be perpetually enjoined from trading in the medicine at all. The appellee asserts in its bill that it has a common law right to those words as a trade-mark for its medicine under any and all circumstances, whether the medicine be sold in connection with labels and wrappers of peculiar style, form, and appearance, or whether the medicine be sold in demijohns, barrels, and tanks without any labels and wrappers whatever, providing it is sold under the name "Syrup of Figs" or "Fig Syrup."

Upon this broad contention as to trade-mark we take issue and submit that the words cannot be lawfully appropriated as a trade-mark under the law of California.

ARGUMENT.

I.

THE WORDS "SYRUP OF FIGS" OR "FIG SYRUP," AS APPLIED TO THE MEDICINE IN QUESTION, ARE EITHER DESCRIPTIVE OR DECEPTIVE, AND IN NEITHER EVENT CAN THEY BE APPROPRIATED AS A TRADE-MARK.

Section 991 of the Civil Code of California regulates the adoption of words and symbols as trade-marks, and provides that no words can be adopted as a valid trade-mark "which relate only to the name, quality, or description of the thing or business or place where the thing is produced or the business is carried on." This is merely the common law rule as to trade-marks, and finds support in *Choynski* vs. *Cohen*, 39 Cal., 501; *Burke* vs. *Cassin*, 45 Cal., 467, and *Schmidt* vs. *Brieg*, 100 Cal., 673.

The leading case in this court is *Canal Co.* vs. *Clark*, 13 Wall., 311, where the rule is stated as follows:

"Nor can a general name or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics be employed as a trade-mark and the exclusive use of it entitled to protection."

As illustrating the extent to which this rule has been carried, it will be interesting to note the subjoining list of words which have been held descriptive:

"Iron Bitters,"

Brown vs. *Meyer*, 139 U. S., 540.

"Sarsaparilla and Iron,"

Shcmidt vs. *Brieg*, 100 Cal., 673.

"Aromatic Schiedam Schnaps,"

Burke vs. *Cassin*, 45 Cal., 467.

"Desiccated Codfish,"

Town vs. *Stetson*, 5 Abb. Pr. (N. S.), 218.

"Antiquarian book store,"

Choynski vs. *Cohen*, 39 Cal., 501.

"Ferro-phosphorated elixir of calisaya bark,"

Caswell vs. Davis, 58 N. Y., 223.

"Cherry pectoral,"

Ayer vs. *Rushton*, Codd Dig., 229.

"Tasteless drugs,"

In re Dick & Co., 9 O. G., 538.

"Burgess' essence of anchovies,"

Burgess vs. *Burgess*, 3 De G. M. & G., 896.

"Balm of a thousand flowers,"

Fetridge vs. *Wells*, 4 Abb. Pr., 144.

"Club-house gin,"

Corwin vs. *Daly*, 7 Bos., 222.

"Extract of night-blooming cereus,"

Phalon vs. *Wright*, 5 Phila., 464.

"Liebig's extract of meat,"

Meat Co. vs. *Hanbury*, 17 L. T. N. S., 298.

"Bees-wax oil,"

In re Hathaway, Com. Dec. '71, p. 97.

"Invisible face powder,"

In re Palmer, Com. Dec. '71, p. 289.

"Razor steel,"

In re Roberts, Com. Dec. '71, p. 100.

"Mammoth wardrobe,"

Gray vs. *Koch*, 2 Mich. N. P., 119.

"Parson's purgative pills,"

In re Johnson Co., 2 O. G., 315.

"Crack-proof India rubber,"

In re Goodyear Rubber Co., 11 O. G., 1062.

"Croup Tincture,"

In re Roach, 10 O. G., 333.

"Cough remedy,"

Gilman vs. *Hunnewell*, 122 Mass., 139.

"Iron stone water pipes,"

In re Rader & Co., 13 O. G., 596.

"Nourishing stout,"

Raggett vs. *Findlater*, L. R. 17 Eq., 29.

"Angostura bitters,"

Siegert vs. Findlater, 7 Ch. Div., 801.

"Julienne soup,"

Godillot vs. *Hazard*, 49 How. Pr., 5.

"Paraffine oil,"

Young vs. *Macrae*, 9 Jur. N. S., 322.

"Lackawanna coal,"

Canal Co. vs. *Clark*, 13 Wall., 311.

"American sardines,"

In re Sardine Co., 2 O. G., 495.

"Straight cut,"

Ginter vs. *Kinney T. Co.*, 12 Fed R., 782.

"Homeopathic Specifics,"

Medicine Co. vs. *Wenz*, 14 Fed. R., 250.

"Cramp cure,"

L. H. Harris vs. *Stucky*, 46 Fed. R., 624.

An application of this doctrine to the facts in hand will show that the words "Syrup of Figs" and "Fig Syrup" cannot lawfully be appropriated as a trade-mark. In and of themselves as a matter of language they can mean only that the medicine to which they are applied is a syrup made from figs, or at least that the medicine contains figs in substantial quantities. That these words were originally adopted by Mr. Queen for the express purpose of being descriptive of the medicine is quite apparent from his testimony. He claims to have "invented" the medicine and to have originated the words. He was a retail druggist in the town of Reno, Nevada, and in 1878 began to experiment with a view to producing a

laxative medicine (Record 81). He was aware of the popular impression, which has existed from time immemorial, that figs possess laxative properties, and he apparently determined to take advantage of and trade upon that popular impression by manufacturing a medicine which contained large quantities of figs or fig juice. As a matter of fact, fig juice is not laxative, at least not more so than any other fruit juice. The laxative property of the fig, if it has any such property, is due to the mechanical action of the *seeds* and *skin* upon the intestinal canal. This appears to be the concensus of opinion among all medical men. The witness Lengfeld, an eminent chemist, says: "Dr. Bruton, who is claimed to be the leading English authority on pharmacology and therapeutics, classes figs with bran, oatmeal, and other undesirable substances, claiming that its laxative properties are entirely due to the small seeds, or so-called small seeds—that is not the strict name—present in the fig." (Record, 308.)

It would appear, however, that in 1878 Mr. Queen was not fully convinced of this fact, and was of the opinion that fig *juice*, when used in substantial quantities in his medicine, would add to its laxative properties; for he began by using large quantities of fig juice. The soluble substance of the figs was dissolved in hot water and put

into the medicine in the shape of fig juice, while the seeds and skin were not used at all. (Record, 90.)

A simple "syrup," in its ordinary signification, is nothing more than a combination of water and saccharine matter, with a flavoring material added, which gives the name to the syrup. Syrups of lemon, orange, vanilla, etc., are familiar illustrations. Mr. Queen, according to his own testimony, manufactured a syrup of figs by dissolving the soluble parts of the fruit and mixing it with hot water and saccharine matter. This syrup he put into his medicine. His idea was to use large quantities of this fig juice, or syrup. He soon found, however, that this was deleterious to the medicine, destroying its stability and causing it to ferment. Therefore, he was compelled to cease using large quantities of fig juice, and reduced it to the present small amount, about one-tenth of one per cent. (Record, 92-93.)

The label originally adopted for his medicine and used until 1896 supports our contention. A copy of it appears opposite page 634 of the record. Upon it is a picture of a fig branch containing figs, enclosed within the name, "California Fig Syrup Company, San Francisco, Cal.," and underneath the cut are the words: "Syrup of figs presents in the most elegant form the laxative and nutritious juice of the figs of California," etc., etc.

And on a separate label attached directly to the bottle were the words: "Syrup of Figs, the California liquid fruit remedy, gentle and effective."

The advertisement of the medicine put forth by Mr. Queen and the California Fig Syrup Company support our contention. The one on page 599 of the record may be taken as a fair sample, and it plainly shows the intent of the designor. Among other things it contains a picture of a young lady holding aloft in one hand a fig branch containing figs, and in the other figs, which she has apparently just plucked from the branch.

Other advertisements will be found on pages 627-629-631 of the record.

It is impossible to misunderstand the intent of Mr. Queen in devising the name, labels, wrappers and advertisements for this medicine. He plainly intended to proclaim to the world, and by force of the language used does in effect proclaim to the world, that the juice of figs enters largely into his medicine as a substantial part thereof, intending thereby to trade upon the popular impression that figs are laxative.

But whatever may have been his actual intention, the words themselves, *ex proprio vigore*, convey the impression that the medicine is a syrup made from figs. Probably no testimony was needed in support of so obvious a

contention; but in order to make assurance doubly sure, we called a number of witnesses who possessed no technical knowledge of pharmacy or any actual knowledge of the constituents of this medicine, but who all knew of the popular impression that figs are laxative, and asked them what impression was produced on their minds when hearing for the first time the name "Syrup of Figs," as applied to a laxative medicine. They invariably replied that they very naturally supposed it to be a syrup made from figs.

Permit us to recall their evidence in part:

HARRY N. GRAY, contractor and member of the prominent firm of Gray Brothers, testified as follows:

"Q. 15. * * * Are you aware of any popular impression amongst people regarding the supposed laxative qualities of figs?

A. I know that the general impression is that they are laxative.

Q. 17. Now, when you first heard this name 'Syrup of Figs,' what did you suppose the article was, from hearing that name?

A. I suposed it was a syrup made from the fruit of figs." (Record, p. 380.)

HENRY E. HALL, wholesale jeweler, testified as follows:

"Q. 10. Now, when you first heard of the article, or saw it advertised as 'Syrup of Figs,' what impression

was produced on your mind as to the constituents of that article, if any? * * * * In other words, what impression, if any, did the name create in your mind concerning the article?

A. That it was a syrup made of figs, a syrup, sugar, etc. (Record, 391.)

X. Q. 16. Did you suppose when you saw this medicine advertised, that it was anything more than simply the juice of figs, or that it was a medicine to be taken in medicinal doses?

A. I suposed that it was a medicine made from the juice of figs." (Record, 394.)

JOSEPH MADISON QUAY, fiduciary agent and club man, testified as follows:

"Q. 23. What impression was conveyed to your mind when you first heard the name 'Syrup of Figs?'

A. The impression was that it was a medicine and laxative, and I think it is so advertised.

Q. 24. What impression was conveyed to your mind as to any constituents of that medicine?

A. Well, I supposed it was made of figs, and was a laxative the same as any other kind of fruit.

Q. 25. Have you been aware of the popular impression among people regarding the supposed laxative quality of figs? A. Yes, sir.

Q. 26. How long have you been aware of such an impression as that?

A. Ever since I was a child.

Q. 27. And when you saw this name 'Syrup of Figs' advertised as a laxative, and when you knew of the popular impression that figs were laxative, what impression

was conveyed to your mind from seeing this advertised name, 'Syrup of Figs,' or 'Fig Syrup,' as to the constituent elements, or any of the constituent elements?

A. I would suppose it was made from figs."

(Record, 398-9.)

JOSEPH D. GRANT, of Murphy, Grant & Co., testified as follows:

"Q. 13. Now, when you saw the name 'Syrup of Figs' in connection with that preparation, what did you suppose were the constituents, or chief constituents?

A. I supposed it was made of figs in some way."

(Record, 422.)

A. CHEESEBROUGH, member of the firm of Williams, Dimond & Co., testified as follows:

"Q. 11. Now, when you saw that name 'Syrup of Figs' advertised in that way, what impression was conveyed on your mind as to the constituents, or any of the constituents, of the preparation?

A. Well, I could only take it as it read, that it was a preparation made from figs, syrup of figs. * * *

Q. 16. Have you ever used this 'Syrup of Figs?'

A. No, sir, I have not. I have thought of using it, but I have never used it. I am very fond of figs, and, consequently, have thought well of the syrup.

Q. 17. Now, what was it, Mr. Cheesebrough, that induced you to think of using it? * * *

A. Because I am passionately fond of figs. There is very seldom a day that I don't have them; don't eat them.

Q. And was it from that fondness for figs that you thought of using this medicine? A. Yes, sir."

(Record, 425-6.)

Nor was the above all. Witnesses for appellee testified to the same effect on cross-examination.

W. P. REDINGTON, wholesale druggist, who sells the medicine of appellee, was asked what impression would be produced on his mind when seeing the name for the first time applied to a laxative medicine. He answered as follows:

"If I had looked at it and saw 'Syrup of Figs' on the label, I would conclude that there was a syrup of figs in it. *I could not come to any other conclusion.* I would conclude that syrup of figs was in it, if I knew nothing about the preparation." (Record, 235.)

And on further cross-examination he gave the following testimony:

"X. Q. 92. Is it your idea that buyers of this 'Syrup of Figs' would be largely influenced in buying it by the fact that there is a popular impression that figs have laxative properties? I refer to those people who do not know the actual constituents of the medicine, but are merely buying it because it is a well advertised laxative?

A. Well, I think many would buy it from the fact that they might consider that syrup of figs was in it. A good many would buy it because it is an extensively advertised preparation, and they come across it and buy it."

(Record, 238.)

X. Q. 112. (Mr. ROWE) Mr. Redington, what did you mean by this expression in your affidavit: 'I regard the name 'Syrup of Figs' or 'Fig Syrup' as applied to that liquid, laxative, medical preparation, as a name for a liquid laxative, a popular suggestion, or a pleasant suggestion?' What did you mean by the phrase 'popular suggestion, or pleasant suggestion?'

A. Because it is the prevailing opinion that figs are laxative, *and it was evidently to convey the impression that there were figs in that preparation.*" (Record, 241.

The following extract is taken from the testimony of J. A. BRIGHT, a retail druggist, called by appellee as a witness:

"X. Q. 144. I ask you what the impression would be that would be carried to the mind by the words for the first time?

A. That it was syrup of figs. (Record, 530.)

X. Q. 149. I presume that you are aware of the popular impression that has prevailed for a long time to the effect that figs are laxative in some way, are you not?

A. Yes, sir.

X. Q. 150. The public have that idea, or a great many of the public have that idea, have they not?

A. Yes, sir.

X. Q. 151. Now, would that make a medicine saleable as a laxative or not, that it contained, or had a statement that it contained, figs in some form or other?

A. I think it would. (Record, 531.)

X. Q. 157. I want to know from your experience as a druggist of long standing in selling medicine of this and other kinds to the public at large, men, women and boys,

for instance, when they come into your store to ask for a laxative medicine, wanting a laxative medicine, when they see this bottle upon your shelf with 'Syrup of Figs' on it, and when they know, or have an idea that figs are laxative, now, from your experience, what would be the impression that would be conveyed to the minds of such people when seeing that name?

A. That it would be a good laxative medicine."

This matter was discussed by Judge Colt in the case of *California Fig Syrup Co.* vs. *Putnam*, 66 Fed. Rep. 751, where we find the following:

"Thus we see that the leading representation on the labels, packages, and in the advertisements of this preparation is, that it is a laxative fruit syrup made from the juice of the California figs. Mr. Winslow, a witness for the plaintiff, fairly expresses the public idea of this compound in reply to the following question:

'What did you suppose "Syrup of Figs" was composed of when you purchased your first bottle? A. I supposed it was made from the natural fruit. It called for the fruit.'

The popularity of this medicine arises from the belief in the mind of the ordinary purchaser that he is buying a laxative compound, the essential ingredient of which is the California fig; whereas, in fact, he is buying a medicine, the active property of which is senna."

This proposition is so obvious that we must apologize for having dwelt on it to such extent. The words themselves convey to the mind of the ordinary purchaser, who

has no knowledge of pharmacy or medicine, no other impression than that testified to by the witnesses, viz: that it represents a laxative medicine composed of figs in some form or other. It may be true that physicians, chemists, and pharmacists, who, by virtue of their technical knowledge, know that there is no such thing as a fig syrup, might not receive that impression from first hearing the name, but this is not true of the ordinary purchaser.

We are unable to distinguish this case from that of *Brown Chemical Co.* vs. *Meyer*, 139 U. S., 540, where the words involved were "Brown's Iron Bitters." This court said, through Mr. Justice Brown:

"And we think the words 'Iron Bitters' are so far indicative of the ingredients, characteristics, and purposes of the plaintiff's preparation as to fall within the scope of these decisions."

The California case of *Schmidt* vs. *Brieg*, 100 Cal., 673, involved the asserted right to appropriate the words "Sarsaparilla and Iron," as applied to a drink. There the court said:

"Words which are merely descriptive of the character, quality, or composition of an article cannot be monopolized as a trade-mark. Thus it has been held that the words 'Iron Bitters' are so far indicative of the qualities of an article as to fall within the scope of the rule. (*Brown Chemical Co.* vs. *Meyer*, 139 U. S., 542.) And

that name is no more generic than the name 'Sarsaparilla and Iron.' * * * We think the words 'Sarsaparilla and Iron' generic terms, and were used for the purpose of indicating not so much the origin, manufacture, or ownership of the beverage, as the quality of the article itself."

The answer which the appellee makes to this obvious proposition is in substance that the words "Syrup of Figs" and "Fig Syrup" are not descriptive of the medicine to which they are applied, but are purely fanciful and arbitrary, because there is no such thing known to pharmacy as a syrup made from figs, that fig juice is not laxative, and that there is such an infinitesimal quantity of fig juice contained in this medicine that it does not give to the compound any virtue whatever, and is of no more value than so much honey or other saccharine matter. Or, to put it in more compact form, the contention substantially is that there is no appreciable quantity of figs in the compound and that the compound is not in reality what its name implies, because there is no such thing known to pharmacy as a syrup made from figs, and, therefore, the name is not descriptive, but purely fanciful and arbitrary. If this contention be true, then the appellee has avoided one difficulty merely to run afoul of another, and we accordingly state our second proposition as follows:

II.

IF THE COMPOUND CONTAINS NO APPRECIABLE QUANTITY OF FIGS AND THERE IS NO SUCH THING KNOWN TO PHARMACY AS A SYRUP MADE FROM FIGS, THEN THE USE OF THE WORDS "SYRUP OF FIGS," OR "FIG SYRUP," AS A TRADE-MARK FOR THIS MEDICINE, IS FRAUDULENT AND WILL NOT BE PROTECTED IN EQUITY.

It is the object of the trade-mark law to make tradesmen act honestly, although that is a difficult thing to accomplish. With that end in view no one is allowed to infringe the valid trade-mark of another who is himself free from blame, and the ground for injunction in such case is that no one will be allowed to palm off his goods on the public as and for those of another. A trade-mark indicates a particular man's goods, and when another person uses that mark on his own goods, he is thereby asserting to the world that those goods, which, as a matter of fact are made by him, are made by the other. In this way he gets the benefit of the reputation of the other man. This is a fraud, and equity prohibits it. The keynote of the trade-mark law is that a tradesman will not be allowed to defraud his neighbor by passing off his goods as those of his neighbor, and this he would do if

he were not prohibited from using his neighbor's trade-mark.

But this same rigid rule against fraud as applied to the infringer is applied with equal force to the trade-mark owner. If *he* is guilty of any fraud in the use of his trade-mark, he will not be protected in practicing that fraud upon the public. If his trade-mark deceives the public and makes them think they are getting something which they are not getting, then he is himself guilty of the same kind of fraud which he thinks to enjoin the infringer from practicing, and will not lend a hand in perpetrating the same. The courts decline to interfere in such case, not from any consideration for the infringer, but because the trade-mark owner himself is guilty of a fraud, and it is a fundamental maxim of equity that "He who hath done iniquity shall not have equity."

In the leading case of *Leather Cloth Co.* vs. *American Leather Cloth Co.*, 4 DeGex, J. & S., 137, 142, 144 (affirmed 11 H. L. Cas., 523), which was a suit where the statements on the face of the trade-mark were untrue, Lord Chancellor Westbury, says:

"When the owner of a trade-mark applies for an injunction to restrain the defendants from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trade-

mark, or in the business connected with it, be himself guilty of any false or misleading representation; for, if the plaintiff makes any material false statement in connection with the property he seeks to protect, he loses, and very justly, his right to claim the assistance of a court of equity. * * * Where any symbol or label claimed as a trade-mark is so constructed or worded as to make or contain a distinct assertion which is false, I think no property can be claimed in it. In other words, the right to the exclusive use of it cannot be maintained."

That case was cited and approved by this court in *Medicine Co.* vs. *Wood*, 108 U. S., 218, where a trade-mark was claimed in the words "Atwood's Vegetable Physical Jaundice Bitters." The labels attached to the bottles stated that the medicine was manufactured by Moses Atwood, of Georgetown, Mass., whereas in fact it was manufactured by another person in New York. Mr. Justice Field, speaking for the court, says, on page 223:

"To put forth a statement, therefore, in the form of a circular or label attached to an article, that it is manufactured in a particular place, by a person whose manufacture there had acquired a great reputation, when, in fact, it is manufactured by a different person at a different place, is a fraud upon the public which no court of equity will countenance."

The latest enunciation of the doctrine by this court is found in the case of *Holzapfels Compositions Co., Limited*, vs. *Rahtjen's American Composition Co.*, decided on

writ of *certiorari* Oct. 21, 1901, and reported in the advance sheets of the Supreme Court Reporter on December 2, 1901, page 8. In that case it was held that the designation of an article as "patented," when as matter of fact it was not patented, was such a fraudulent statement as disentitled the owner of the trade-mark to any relief in equity, and this court said, through his Honor, Mr. Justice Peckham:

"A symbol or label claimed as a trade-mark, so constituted or worded as to make or contain a distinct assertion which is false, will not be recognized, nor can any right to its exclusive use be maintained."

And in support of the doctrine this court cited *Manhattan Medicine Co.* vs. *Wood*, 108 U. S., 218, and *Allan B. Wrisley Co.* vs. *Iowa Soap Co.*, 104 Fed. Rep., 548.

The Wrisley case, above cited as being good law, seems to us conclusive of the case at bar. There the plaintiff had adopted as a trade-mark for soap, which he was manufacturing in the United States, the words "Old Country Soap," and the court held that those words in and of themselves conveyed the impression to purchasers that the soap was made in the old country. Consequently, it was held to be a fraud, because the soap was not made in the old country. If that be good law, how is it possible to avoid the conclusion that the term "Syrup of Figs"

conveys the impression that the medicine is made from figs? Can any two cases be more nearly alike in principle?

While it is not necessary to cite any further cases on this point, we have ventured to collect a few of the most striking merely as a matter of convenient reference, should this court desire to consider them.

In *Clotworthy* vs. *Schepp*, 42 Fed., 62, 63, the right to a trade-mark was claimed in the word "Puddine" in connection with the words "Rose" and "Vanilla." In his opinion Judge Lacombe says:

"The complainant himself is engaged in deceiving the very public whom he claims to protect from the deception of others. He calls his preparation 'fruit' puddine. In nine different places on his package this word 'fruit' is repeated, as descriptive of the article, and a dish of fruit (pears, grapes, etc.,) is most prominently depicted on one face of each packet. His packages plainly suggest that fruit of some kind enters into his compound. A chemical analysis produced by defendant, the substantial accuracy of which is not disputed, discloses the fact that his 'Puddine' is composed exclusively of corn starch, a small amount of saccharine matter, and a flavoring extract, with a little carmine added to give it color. It contains no fruit in any form. Under these circumstances complainant's rights are not sufficiently clear to warrant the granting of a preliminary injunction."

In *Alden* vs. *Gross*, 25 Mo. App., 123, 128. 130, a trade-mark was claimed in the words "Fruit Vinegar." In that case the court says:

"The vinegar thus branded was not manufactured out of fruit, in the plain, ordinary, usual sense of that term, but out of low wines distilled from cereals, and fruit enters into its composition only to a very insignificant extent. * * * It would be a novel application of the rule governing the subject of trade-marks, if one who manufactures vinegar out of cereals could appropriate to the article thus manufactured the word 'Fruit,' and thereby exclude another from using the word as descriptive of an article which is, in point of fact, manufactured out of fruit. * * * But whether the word 'Fruit,' in this connection, is purely indicative of the character or quality of the article or not, the plaintiffs' exclusive claim to it must fail on the further ground that the use of the word, in that connection, is clearly deceptive."

In *Connell* vs. *Reed*, 128 Mass., 477, the plaintiff sought to establish the exclusive right to the words "East Indian" as applied to his remedy. In that case Chief Justice Gray says:

"The conclusive answer to this suit is * * * that the plaintiffs have adopted and used these words to denote, and to indicate to the public, that the medicines were used in the East Indies, and that the formula for them was obtained there, neither of which is the fact. Under these circumstances to maintain this bill would

be to lend the aid of the court to a scheme to defraud the public."

In *Siegert* vs. *Abbott*, 61 Md., 276, 284, the subject matter of the trade-mark was "Angostura Bitters," which purported to have been prepared by Dr. Siegert at Angostura, now Port of Spain, Trinidad. In fact, Dr. Siegert was dead, and had never lived at the Port of Spain. In dismissing the bill the court says:

"It is a general rule of law, in cases of this kind, that courts of equity will not interfere by injunction where there is any lack of truth in the plaintiff's case; that is, where there is any misrepresentation in his trade-mark or labels."

In *Seabury* vs. *Grosvenor*, 14 Blatchf., 262, 263, Fed. Cas. No. 12,576, the word "Capcine" was sought to be appropriated as a trade-mark. In that case Mr. Justice Blatchford says:

"A registered trade-mark is claimed in the word 'Capcine.' Courts of equity refuse to interfere in behalf of persons who claim property in a trade-mark, acquired by advertising their wares under such representations as these above cited, if they are false. It is shown that there is no such article as 'Capcine' known in chemistry or medicine or otherwise. The authorities are clear that, in a case of this description, a plaintiff loses his right to claim the assistance of a court of equity."

In *Krauss* vs. *Jos. R. Peebles' Sons Co.*, 58 Fed., 585, 594, it was shown that the liquor sold as "Pepper Whisky" was in fact a mixture of Pepper whisky and other whiskies. Judge Taft, in his opinion, says:

"To bottle such a mixture, and sell it under the trade label and caution notices above referred to, is a false representation, and a fraud upon the purchasing public. A court of equity cannot protect property in a trade-mark thus fraudulently used. It is not material whether the foreign whisky mixed with Pepper's is as good or better whisky than Pepper's, or whether the mixture is better than pure Pepper whisky. The public are entitled to a true statement as to the origin of the whisky, if any statement is made at all. The complainants and Pepper are not to be protected in a deception of the public, even if it works to the advantage of the public."

In *Manufacturing Co.* vs. *Beeshore*, 8 C. C. A., 215, 59 Fed., 572, 574, a trade-mark was claimed in the words "One-Night Cough Cure." In the opinion of the court Mr. Justice Shiras says:

"In the present case, the so-called trade-mark, 'One-Night Cough Cure,' asserts a manifest falsehood or physiological impossibility. A cough or cold, so far seated as to require medical treatment, cannot be cured in a single night, and a pretense to the contrary is obviously an imposition on the ignorant."

In *Fetridge* vs. *Wells*, 13 How. Pr., 385, 390, 393, the plaintiff sold a soap under the name of "Balm of Thou-

sand Flowers." In denying the plaintiff's right to the exclusive use of these words as a trade-mark, Judge Duer says:

"I am fully convinced that the name 'Balm of Thousand Flowers' was invented and is now used to convey to the minds of purchasers the assurance that the highly scented liquid to which the name is given is, in truth, an extract or distillation from flowers, and, therefore, not merely an innocent, but a pleasant and salutary preparation. Not only is this the meaning that the words used naturally suggest, but in my opinion it is that which they actually and plainly express, and were designed to convey. * * * Let it not be said that it is of little consequence whether this representation be true or false. No representation can be more material than that of the ingredients of a compound which is recommended and sold as a medicine. There is none that is so likely to induce confidence in the application and use of the compound, and none that, when false, will more probably be attended with injurious, and perhaps fatal, consequences."

In *Schmidt* vs. *Brieg*, 100 Cal., 672, 678, the Supreme Court of California, in a case where a trade-mark was claimed in the words "Sarsaparilla and Iron," says:

"We think the words 'Sarsaparilla and Iron' are generic terms, and were used for the purpose of indicating, not so much the origin, manufacture, or ownership of the beverage, as the quality of the article itself. * * * The words 'Sarsaparilla and Iron' describe ingredients well known to the public. * * * But it is claimed

by respondents (plaintiffs below) that the words 'Sarsaparilla and Iron' do not, in fact, indicate the character, kind, or quality of their beverage; that it is not a composition of sarsaparilla and iron, but a solution of various substances; that it contains only a small quantity of sarsaparilla and a small quantity of iron, and the name was given to the beverage only as a name by which it might be known, without in any way being descriptive; but it is sufficient to say in answer to this claim that the name given to the article is either generic, or it is of such a character that it can as well be applied to defendants' beverage as to the plaintiffs."

In *Phalon* vs. *Wright*, 5 Phila., 464, 467, the subject of the trade-mark was "Extract of Night-Blooming Cereus." In that case the court says:

"They (the plaintiffs) admit that the name is a deception, as far as it is used to indicate the real character of the compound; that the perfume is no extract from the flower, and that the trade-mark is in that respect a pure invention. 'The Night-Blooming Cereus,' however, exists, a flower well known by that name, which, when first introduced to public notice, excited much attention. An extract may be made from that flower; any perfumer has the right to make such an extract and to call it what it is, by the name of the flower."

In *Prince Manuf'g Co.* vs. *Prince Metallic Paint Co.*, 135 N. Y., 24, 38, 39, the New York Court of Appeals, in denying the right to a trade-mark in the words "Prince's

Metallic Paint," by reason of a false representation as to the place from which the ore was obtained, says:

"Any material misrepresentation in a label or trademark as to the person by whom the article is manufactured, or as to the place where manufactured, or as to the materials composing it, or any other material false representation, deprives a party of the right to relief in equity. The courts do not, in such cases, take into consideration the attitude of the defendant. * * * And, although the false article is as good as the true one, 'the privilege of deceiving the public, even for their own benefit, is not a legitimate subject of commerce.'"

Permit us to apply the law announced by these cases to the facts in hand. In the first place, it may be very seriously doubted whether the courts would protect this medicine in any event, even though appellee was guilty of no fraud, for the reason that it is a *quack* medicine. We understand this term to mean a medicine whose composition is kept secret and is to be used without the prescription of a physician. In the case of *Kohler Manufacturing Co.* vs. *Beeshore*, 59 Fed Rep., 547, Mr. Justice Shiras, in delivering the opinion of the court of appeals of the third circuit, says:

"It has been more than once held in this circuit that courts of equity will not intervene by injunction in disputes between the owners of quack medicines, meaning thereby remedies or specifics whose composition is kept

secret and which are sold to be used by the purchasers without the advice of regular or licensed physicians. *Fowle* vs. *Spear* (Nov. term, 1847), 7 Pa. Law J., 176; *Heath* vs. *Wright*, 3 Wall. Jr., 141. A similar view has prevailed in several state courts. *Wolfe* vs. *Burke*, 56 N. Y., 115; *Smith* vs. *Woodruff*, 48 Barb., 438; *Laird* vs. *Wilder*, 9 Bush., 132."

The appellee's medicine would appear to fall within the above definition. It is manufactured by a secret formula and its ingredients are not known to the public except that senna is its basis and a minute quantity of fig juice is used, which latter it is conceded adds no beneficial effects to the medicine.

Physicians on behalf of appellant testified directly that the medicine is a quack remedy and that they never prescribed it or allowed their patients to use it. (See testimony of Dr. Gardner, page 414, and Dr. Dodge, page 558.)

In view of the foregoing, we think it very doubtful whether the court would protect this medicine in any event, for the reason that it is probably a quack remedy. But however that may be, whether it be a quack medicine or not, our position is that the appellee has been guilty of such fraudulent practices as will disentitle it to any relief in a court of equity. The appellee does not come into court with clean hands. He "hath committed iniquity," and, therefore, "cannot have equity."

The facts showing that the appellee has for many years been practicing a fraud on the public in connection with its medicine are without dispute. It is prepared according to a secret formula. Its essential constituent is stated to be *senna*. A microscopical amount of fig juice is added, but it has no more effect than the same quantity of any other saccharine matter would have. It has no medicinal properties whatever, and is beyond all question put into the medicine merely for the purpose of furnishing a foundation for the fraudulent statement that figs enter into the composition of the medicine. All the other component parts are unknown to the public. Mr. Queen bunches them together under the nebulous term "aromatic carminatives," but declines to state what they are (Record, p. 105). The medicine itself is called "Syrup of Figs" and "Fig Syrup," notwithstanding the fact that there is no such thing known to pharmacy as a syrup made from figs, and that, if such a syrup should be made, it would not possess laxative properties. This fact, however, though known to pharmacists, is not known to the public at large who use the medicine and who from hearing the name used in connection with a laxative compound would naturally conclude that the medicine was a syrup made from figs, just as they would naturally conclude that syrup of

hoarhound is a syrup made from hoarhound, or syrup of strawberry is a syrup made from strawberry.

Furthermore, there is a popular impression which has existed from time immemorial that figs possess laxative properties. Therefore, when a person hears of a liquid laxative medicine called "Syrup of Figs," he very naturally concludes, not only that the medicine is made from figs, but that it possesses the laxative properties popularly attributed to figs.

When Mr. Queen originated this medicine he undoubtedly intended to trade upon that popular impression and to induce the public to suppose that the medicine was made from figs and contained the laxative properties of figs. The literature issued by him and his company in connection with the medicine supports this theory. On the label originally used and continued in use for many years until the Eastern courts adjudged it to be a fraud, we find this statement: "Syrup of Figs presents in the most elegant form the laxative and nutritious juice of the figs of California combined with the medicinal virtues of plants known to be beneficial to the human system, forming an agreeable and effective laxative to permanently cure habitual constipation and the many ills attendant on a weak or inactive condition of the kidneys, liver, stomach and bowels."

And on the interior label affixed directly to the bottle were the words: "Syrup of figs, the California liquid fruit remedy, gentle and effective."

Here we find a batch of false statements. The medicine is not a syrup of figs; for according to Mr. Queen's own statement there is no such thing known to pharmacy as a syrup of figs. Nor is this medicine made from figs, because the amount of fig juice in it is so infinitesimal that it gives no effect to the compound whatever.

The next statement is equally false, viz: that the medicine "presents in the most elegant form the laxative and nutritious juice of the figs of California." The amount of fig juice in the medicine is so infinitesimal that it can scarcely be said to possess any fig juice at all, certainly not enough to add to it any value. But worse than all, Mr. Queen testified that fig juice does not possess laxative powers, and in this he is sustained by all the medical authorities. The statement is so palpably false and fraudulent that it would be useless to dwell on the subject.

Furthermore, the statement that the medicine will permanently cure habitual constipation is likewise false. There is no drug or compound of drugs which will permanently cure that ailment. Certainly senna, the basis of this medicine, will not do it. On this point all medi-

cal men agree. The two physicians called upon in that regard testified to the same. See testimony of Dr. Kerr (Record, page 568) and Dr. Dodge (Record, 556).

The statement that the medicine is a *California liquid fruit remedy* is equally false. It is not a fruit remedy at all. The quantity of fruit in it is infinitesimal. Nor was it a California fruit remedy at the start, because it was invented, manufactured and sold in the State of Nevada. Beyond all doubt the public has been grossly deceived by that statement, purchasing a concoction of drugs under the belief that they were purchasing a liquid fruit remedy.

And so likewise with regard to the advertising literature issued by appellee and published in medical journals and newspapers throughout the country. It seems therefrom that it was the studied effort of appellee to induce the public at large to believe that the essential ingredients of the medicine was the California fig, whereas as matter of fact it has practically no figs in it, and its essential ingredient is senna.

And finally, there is a bit of testimony in the record which places the matter beyond all doubt. When Mr. Queen "invented" his medicine Mr. George Alt, of Glendale, in the State of Nevada, furnished the money for floating the enterprise, and for a period of eighteen

months or two years Mr. Alt manufactured the medicine for Mr. Queen on his farm at Glendale. The medicine had originally been manufactured by Mr. Queen at Reno; but it was deemed advisable to change the place of manufacture to Glendale, where Mr. Alt personally manufactured the medicine. Mr. Queen furnished him with the formula and instructed him in the details of manufacture. In pursuance thereof Alt manufactured the medicine under and according to the formula so furnished him by Mr. Queen. This formula called for no figs nor fig juice nor any part of the fig. As actually made the medicine contained no figs nor fig juice nor any part of the fig, according to Mr. Alt's testimony.

The formula is as follows:

COMPLAINANT'S FORMULA.

(According to Alt's Testimony.)

" 50 lbs. Alexandria Senna.
22 gall. Hot Water.
100 lbs. Sugar.
2 oz. Cinnamon Oil.
2 oz. Clove Oil.
2 oz. Anise Oil.
2 gall. Alcohol.

Hot water poured over the senna and stands two hours before it is pressed; the alcohol and oils are then

added. It stands twenty-four hours and then it is strained; the sugar is then added.

Ground ginger is thrown between the layers of the senna and pressed with the leaves together; it prevents griping.

2 lbs. to gall."

It will thus be seen that the medicine which Mr. Queen claims to have "invented" is nothing more than a decoction of senna mixed with sugar and water and some flavoring extracts, with a little ginger added to prevent griping. The basis of the compound is senna, a drug which has been known for years to all medical men as a purgative. No figs appear in the formula, not even that "suspicion of fig juice" referred to by Judge Taft as having been put into the medicine to give some color to the statement that it contained figs. But in order to perpetuate the deception on the public which he had theretofore inaugurated and so successfully carried out, Mr. Queen delivered to Alt, along with the formula, an old gunny-sack filled with figs and instructed him to expose them to the public view at the factory, so that the public at large from seeing the same would naturally conclude that figs were used in the medicine. Mr. Alt testified to these facts and produced the formula. Mr. Queen admits that he delivered over to Mr. Alt the gunny-sack filled with figs, but denies that he instructed him to de-

ceive the public with them (Record, 502). The testimony given by Mr. Alt on the subject is as follows:

"Q. 24. Now, will you please give the formula under which that 'Fig Syrup' was then made? If you have any data in your possession, just produce it and state how you came by it and what it is.

A. (Producing.) I came by this when I went to manufacture it. Mr. Queen turned it over to me. The company insisted upon him giving us the formula so that it would not be kept secret from them when I went to manufacture it (Record, 326).

Q. 25. Mr. Alt, when you started in to manufacture this stuff up there for the California Fig Syrup Company, how did you get the formula by which to manufacture it?

A. Mr. Queen gave it to me.

Q. 26. Was it written out on paper?

A. Yes, sir.

Q. 27. Where was it put. * * * ?

A. The first formula was given to me to manufacture it by, and afterward the company objected to making a record in our minute-book of the formula. Mr. Queen would not agree to that, but he said he would give us the formula and he would lock it up.

Q. 27. Was it written out on paper?

A. Yes, sir.

Q. 28. Was it locked up? A. Yes, sir.

Q. 29. Where?

A. In a tin box left with the secretary. The secretary turned it over, I presume. I don't know anything about that.

Q. 30. Who was the secretary?

A. Sol. Levi. * * *

Q. 33. If I understand, this paper which you have produced, is not the original, but it is a copy?

A. No, it was copied from it.

Q. 34. When and where was this copy made?

A. Made in Reno.

Q. 35. By whom? A. By Sol. Levi.

Q. 36. When? A. In the spring of 1882.

Q. 37. Is it in his handwriting? A. Yes, sir.

Q. 38. Were you present there?

A. Yes, sir; I read it off to him to copy.

Q. 39. You read off the original to him?

A. Yes, sir.

Q. 40. And he made a copy?

A. Yes, sir.

Q. 41. Then what was done with this copy?

A. He put it in his safe. It has been there ever since.

Q. 42. When did you get this copy from him?

A. About a week ago.

Q. 43. Is this a true copy of the original formula?

A. All except the ginger below there. That was added after I went to manufacturing it.

Q. 44. I mean, is this a correct copy of the formula as you manufactured the medicine?

A. That is the correct formula as I manufactured it. * * *

Q. 45. Mr. Alt, I don't observe in this formula any figs. *Were there not any figs in the medicine?*

A. *No, sir.*

Q. 46. *Do you mean to say there were no figs at all or anything in the shape of figs?*

A. *No, sir; none whatever.*

Q. 47. Did you have any figs around the establishment?

A. I believe there was a sack bought and set in the wrapping house. * * *

Q. 50. Who had that done?

A. Mr. Queen.

Q. 51. Did he give any reason for it?

A. Well, he wanted to keep up an appearance that we were using figs, he said.

Q. 52. *But, as a matter of fact, there were no figs used at all?*

A. *None whatever; no, sir.*

Q. 53. During the whole time you were manufacturing it?

A. Not any. * * *

Q. 62. Now, did you have any conversation with Mr. Queen wherein he stated the reason for having adopted this name, 'Syrup of Figs,' or anything in that connection?

A. Well, he thought it was a good name to sell by; that a great many people thought that figs was a laxative, and he adopted the name for that purpose. * * *

Q. 63. Did Mr. Queen make any statement to you substantially of that kind?

A. Yes, sir. (Record, 346, 347, 348, 349, 350, 351.)

X. Q. 43. Did you at any time at that place, at Glendale, keep figs in sight so that if anybody came there—

A. (Interrupting).—Yes, sir.

X. Q. 44. You did that? A. Yes, sir.

X. Q. 45. You did that by direction of Mr. Queen?

A. Yes, sir; he ordered the figs.

X. Q. 46. That was at Glendale?

A. Yes, sir.

X. Q. 47. Then you did have the figs at Glendale?

A. Yes, sir.

X. Q. 48. How many did you have there?

A. He got a sack full of them.

X. Q. 49. Where were they?

A. They were left in the wrapping house."

(Record, 356.)

* * * * * * * *

X. Q. 62. Now, don't you know that Mr. Queen instructed you always in the manufacture of this medicine to use figs?

A. No, sir; never.

X. Q. 63. He did not? A. He never did.

X. Q. 64. You are positive about that?

A. I am.

X. Q. 65. Your idea was that that sack of figs was there simply for the purpose of deception?

A. *That is what he said himself; to keep it there and people would think we were using them.*"

(Record, 357.)

It further appears that Mr. Alt made an affidavit in the case of *California Fig Syrup Company* vs. *Improved Fig Syrup Company*, and he was questioned about the same on cross-examination by appellee's counsel herein; but after so questioning him concerning that affidavit, the appellee's counsel declined to put it in evidence (Record, 363), and thereupon we offered the affidavit in evidence ourselves in connection with the cross-examination thereon to which Mr. Alt had been subjected. The material portion of that affidavit is as follows:

"That he was one of the original incorporators of the complainant corporation, and acted as president of said corporation from June, 1882, until October 30, 1883.

"Affiant avers that he was engaged in the manufacture of complainant's laxative compound, commonly known as 'Syrup of Figs' or 'Fig Syrup' under the direction of R. E. Queen, one of the officers of said company, and now the president and general manager thereof, from January 1, 1882, until October 30, 1883; and that he, said affiant, thereby became acquainted with the ingredients which constitute complainant's said compound. Affiant further avers that said compound, during the said time, and while said affiant was so engaged in its manufacture, contained no fig extract or syrup of figs, and that no figs whatsoever were used in manufacturing said compound.

"That the factory of the complainant corporation, during the time hereinbefore mentioned, was situated in Glendale, State of Nevada.

"Affiant further avers that said R. E. Queen, president and general manager of said complainant corporation, said to this affiant that it would be well to keep figs in sight, in order that people coming into the factory would think that figs were used in the manufacture of the compound. Affiant further avers that said figs were placed on exhibition solely for deception, and were never used in the manufacture of said 'Syrup of Figs' during the time that said affiant was engaged in the manufacture thereof.

"Affiant further states that he has no knowledge of any change having been made in the formula used while he was manufacturing the fig syrup; and avers that said R.

E. Queen wrote to this affiant and asked him for the formula of 'Syrup of Figs' used by affiant while he was so as aforesaid manufacturing said compound, and after this affiant had ceased to have any interest in the said corporation."

It is quite apparent from the foregoing that this medicine had its inception in fraud. No reason has been advanced for doubting the veracity of Mr. Alt, and we submit that his testimony bears the impress of truth. Furthermore, it would have been a senseless proceeding to have gone to the expense of extracting the soluble portion of figs, preparing it into a syrup, and placing it in the medicine, for, as Mr. Queen justly remarks, this fig juice has no more effect than so much honey or other saccharine matter. The truth of the whole matter is, that Mr. Queen determined to take advantage of the popular impression that figs are laxative, and to give the public the impression that this medicine contained figs, knowing, as a chemist, that fig juice is not laxative, and, even if it were, that the infinitesimal quantity which he claims to use in the medicine would have no effect.

This conclusion is rendered irresistible when we remember that from the beginning of the manufacture of the medicine in 1878 up to the year 1896, a period of eighteen years, Mr. Queen and his company advertised and stated on his labels, that the preparation was a

California Liquid Fruit Remedy, and that it "*Presents in the most elegant form the laxative and nutritious juice of the figs of California.*"

As further showing probable fraud on the part of appellee, we cite the fact that its medicine is prepared by a secret formula, and the witness for appellee, who superintends the manufacture of the compound, refused on the witness stand to give the formula or to state what were the constituents of the medicine. We think we were entitled to know these facts. Where a person comes into a court of equity asking its protection for the name of a medicine prepared and sold by him, it is a most material fact that the court should know what are the constituents of the medicine in order to determine whether or not it is a proper case in which to give protection. Mr. Richard E. Queen offered himself as a witness on behalf of appellee and testified in the most general terms that the basis of the medicine was senna, and that it contained a small quantity of fig juice, less than one per cent., but declined to state what were the other constituents. (Record, 104-5.)

Mr. LOUIS T. QUEEN, a brother of Richard E. Queen, was also called as a witness on behalf of complainant. He testified that he was superintendent of the manufacturing department of the appellee engaged in

the actual preparation of the medicine, knew what were its constituents, and how it was made, but declined to say what were its constituents.

(Record, 255-6-7-8-9, *et seq.*)

We submit that we were entitled to cross-examine the witness as to the ingredients of the medicine, and the refusal of the witness to answer such questions was so far unreasonable as to disentitle complainant to any relief in equity. The complainant had, by general testimony, endeavored to show that the medicine in question was a good laxative and contained nothing harmful to the human system. Therefore, on cross-examination, we were clearly entitled to know the constituents of the medicine, so that the court could determine whether or not it contained anything harmful. It is a well known fact that a great many quack medicines contain ingredients harmful to the human system, and we were entitled to know whether that was true of the one before the court. The attitude of appellee is most unreasonable. It comes into court with what we charge to be a quack medicine, prepared according to a secret formula and containing secret ingredients, and while proclaiming to the world and assuring the court that the medicine is an excellent one and contains nothing harmful, refuses to state what the actual constituents are. Will

a court of equity lend a helping hand to such an unreasonable litigant?

The attitude of appellee becomes still more grotesque when we recall the fact that it charges the appellants with manufacturing a spurious medicine containing ingredients harmful to the human system. The appellants put in evidence the formula under which their medicine is made, showing that one of the ingredients was a small quantity of hyoscyamus, commonly called henbane. Of course, it is a well known fact that henbane is a poison, but it is equally well known that when mixed with other ingredients in such small proportions as that shown in our formula, it is not poisonous nor harmful, but is beneficial. Nevertheless, the appellee made a great capital of the fact that one of the ingredients of our medicine was a poison.

Another ingredient found in our formula is alcohol, which is used as a solvent for the drugs, and appellants endeavored to make capital of this fact by the pretense that the percentage of alcohol was so great as to make the medicine dangerous.

Thus we see that while the appellee was endeavoring by all the means in its power to show that the "Syrup of Figs" manufactured by us was a spurious article and harmful to the human system, at the same time both its

manager and its chemist were declining positively to state what were the ingredients of its own "Syrup of Figs." A more unreasonable position cannot well be imagined.

We think the facts disclosed by this record present a case of the most glaring fraud ever perpetrated upon a gullible public. It is no answer to say that the medicine is a good laxative, whether it has in it figs or not. The fact still remains that the purchasers *think* and *believe* that it has figs in it, and purchase it for that reason, being under the impression that figs are laxative.

In *Krauss* vs. *Jos. R. Peebles Sons Co.*, 58 Fed. Rep., 585, a similar question arose. Plaintiff was advertising a whisky as "Pepper" whisky, which was in fact a mixture of Pepper and other whiskies. It was insisted by plaintiff that his whisky was as good as, or better than, Pepper whisky, and for that reason the representation on his label was harmless. But the court said:

"It is not material whether the foreign whisky mixed with Pepper's is as good or better whisky than Pepper's, or whether the mixture is better than pure Pepper whisky. The public are entitled to a true statement as to the origin of the whisky, if any statement is made at all. The complainants and Pepper are not to be protected in a deception of the public, even if it works to the advantage of the public."

And so likewise in *Fetridge* vs. *Wells*, 13 How. Pr., 385, where the plaintiff had adopted as a trade-mark for soap the name "Balm of Thousand Flowers." The soap was not made from flowers, but it was shown to be an excellent article, and its owner insisted that the statement was, therefore, innocent. But Judge Duer said:

"Let it not be said that it is of little consequence whether this representation be true or false. No representation can be more material than that of the ingredients of the compound which is recommended and sold as a medicine. There is none that is so likely to induce confidence in the application and use of the compound, and none that, when false, will more probably be attended with injurious and perhaps fatal consequences."

A similar ruling was made in *Prince Manf'g Co.* vs. *Prince Metallic Paint Co.*, 135 N. Y., 24.

The case in hand falls clearly within the reasoning of the cases cited. The purchasers of "Fig Syrup" believe that it contains figs, and they purchase the medicine because of that belief. Hence, the statement is a fraudulent one, and the appellee cannot be protected in perpetuating such fraud.

The facts of the case at bar bring it squarely within the rule of the Supreme Court of California in the case of *Schmidt* vs. *Brieg*, heretofore quoted. The plaintiff

there sued to protect as a trade-mark the words "Sarsaparilla and Iron," as applied to a beverage. The defendant contended that the words were descriptive, and for that reason could not be appropriated as a trade-mark. The plaintiff replied by showing that there was such a small quantity of sarsaparilla and iron in his beverage that it did not give to the compound any distinctive characteristic, and for that reason it was not descriptive, but purely fanciful and arbitrary.

That is identically the situation now before the court in the case at bar.

But the Supreme Court of California was not impressed with plaintiff's argument in that regard, and held that it was unsound. We quote the following extract from the opinion at page 678:

"But it is claimed by respondents that the words 'Sarsaparilla and Iron' do not in fact indicate the character, kind, or quality of their beverage; that it is not a composition of sarsaparilla and iron, but a solution of various substances; that it contains only a small quantity of sarsaparilla and a small quantity of iron, and the name was given to the beverage only as a name by which it might be known, without in any way being descriptive; but it is sufficient to say in answer to this claim, that the name given to the article is either generic or it is of such a character that it can as well be applied to defendant's beverage as to plaintiff's; and this being so, as was said in *Canal Company* vs. *Clark*, 13 Wall., 327, al-

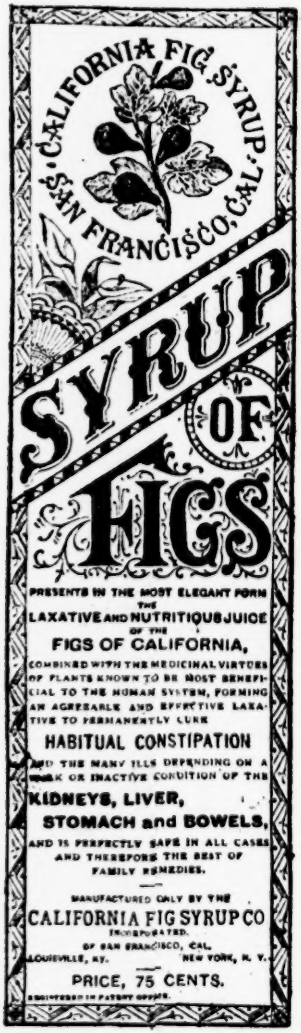
though the use of the name may be for the effect of causing the public to mistake as to the origin or ownership of the product, if it is just as true in its application to his goods as it is to those of another who first supplied it, there is no legal wrong done, the words or combinations being of such a character as to designate respectively well known articles of commerce."

It would seem impossible to find two cases more nearly parallel, and it was probably that fact which deterred the appellee here from bringing this case in the state court, and induced him to select the federal court as a forum. Had the case been brought in the state court, what doubt could there be as to the result? The lower court would have been bound by the decision of the supreme court in the "Sarsaparilla and Iron" case, and the latter tribunal would doubtless have affirmed the ruling.

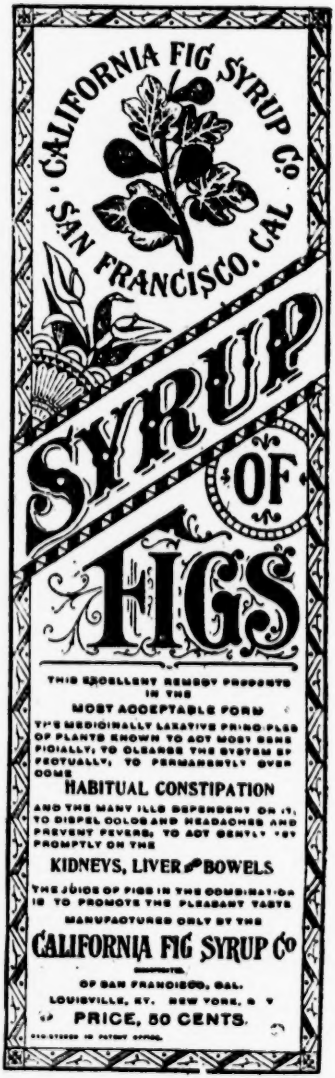
The reasoning of Judge Colt in the case of *California Fig Syrup Co.* vs. *Putnam* (66 Fed. Rep., 673), regarding this identical name, seems to us unanswerable. Said he:

"The popularity of this medicine arises from the belief in the mind of the ordinary purchaser that he is buying a laxative compound, the essential ingredient of which is the California fig, whereas, in fact, he is buying a medicine the active property of which is senna. The ethical principle on which the law of trade-marks is based will

OLD LABEL.


CALIFORNIA FIG SYRUP
SAN FRANCISCO, CAL.
SYRUP
OF
FIGS
PRESENTS IN THE MOST ELEGANT FORM THE
LAXATIVE AND NUTRITIOUS JUICE OF THE
FIGS OF CALIFORNIA,
COMBINED WITH THE MEDICINAL VIRTUES OF PLANTS KNOWN TO BE MOST BENEFICIAL TO THE HUMAN SYSTEM, FORMING AN AGREEABLE AND EFFECTIVE LAXATIVE TO PERMANENTLY CURE
HABITUAL CONSTIPATION
AND THE MANY ILLS DEPENDING ON A SLUGGISH OR INACTIVE CONDITION OF THE
KIDNEYS, LIVER,
STOMACH and BOWELS,
AND IS PERFECTLY SAFE IN ALL CASES AND THEREFORE THE BEST OF FAMILY REMEDIES.
MANUFACTURED ONLY BY THE
CALIFORNIA FIG SYRUP CO
INCORPORATED.
OF SAN FRANCISCO, CAL.
LOUISVILLE, KY. NEW YORK, N. Y.
PRICE, 75 CENTS.
REGISTERED IN PATENT OFFICE.

NEW LABEL.


CALIFORNIA FIG SYRUP Co
SAN FRANCISCO, CAL
SYRUP
OF
FIGS
THIS EXCELLENT REMEDY PRODUCTS IN THE
MOST ACCEPTABLE FORM
THE MEDICINALLY LAXATIVE PRINCIPLES OF PLANTS KNOWN TO ACT MOST BENEFICIALLY, TO CLEANSE THE SYSTEM EFFECTUALLY, TO PERMANENTLY OVERCOME
HABITUAL CONSTIPATION
AND THE MANY ILLS DEPENDENT ON IT, TO DISPEL COLDS AND HEADACHES AND PREVENT FEVERS; TO ACT GENTLY YET PROMPTLY ON THE
KIDNEYS, LIVER & BOWELS
THE JUICE OF FIGS IN THE COMBINATION IS TO PROMOTE THE PLEASANT TASTE
MANUFACTURED ONLY BY THE
CALIFORNIA FIG SYRUP Co
INCORPORATED.
OF SAN FRANCISCO, CAL.
LOUISVILLE, KY. NEW YORK, N. Y.
PRICE, 50 CENTS.
REGISTERED IN PATENT OFFICE.

not permit of any such deception. It may be true, as a scientific fact known to physicians and pharmacists, that the syrup of figs has little or no laxative property; but this is not the belief of the general public. They purchase this preparation on the faith that it is a laxative compound made from the fruit of the fig, which is false. This is not an immaterial representation the effect of which is harmless, but it is a representation which goes to the very essence of the plaintiff's right to a trademark in these words. The cases are numerous where the courts have refused to grant relief under these circumstances."

The answer which the appellee made to this position in the lower court was the assertion that, after the decision of the eastern courts holding the statements above referred to, false and fraudulent, the labels had been changed by removing therefrom the said false statement and by advertising to the world that the basis of the medicine was senna. On the adjoining page will be found in parallel columns the new and old labels. The new label still has the same appearance as the old one. It has the fig branch surrounded by the words "California Fig Syrup Company, San Francisco, Cal." It still has the name "Syrup of Figs." But instead of the assertion that it "Presents in the most elegant form the laxative and nutritious juice of the figs of California," it has the following statment:

"This remedy presents in the most acceptable form, *the medicinal laxative principles of plants known to act most beneficially to cleanse the system effectually, to permanently overcome habitual constipation and the many ills dependent on it*, to dispel colds and headaches and prevent fevers, to act gently and promptly on the kidneys, liver, and bowels. The juice of figs in the composition is to promote the pleasant taste."

In other words, appellee erased from its *interior label* (not the label in controversy) the statement that the medicine was a California liquid fruit remedy, and also the direct statement on the outside carton (the label in controversy) that it contained the laxative and nutritious juice of figs of California, and in place thereof substituted the ambiguous language last quoted. The new label still contains the words "California Fig Syrup Company, San Francisco, California," surrounding a fig branch bearing the ripe fruit, and also the words in bold type, "Syrup of Figs." It still contains the false statement that the medicine overcomes habitual constipation, and there is added to it another false statement which was not on the original label, viz., that the juice of figs in the composition is *to promote the pleasant taste*. The small amount of fig juice used cannot, and does not, promote the pleasant taste, and the court of appeals so held in the case at bar.

It also contains on each end a cut of a young lady

holding a fig branch in her hands, something which was not on the original label and which serves to accentuate the fraud. One of those cuts is in black and white while the other is in colors. See complainant's Exhibit A. on the folder opposite page 634 of Record.

We maintain that this new label is as fraudulent and deceptive as the old one. The words "Syrup of Figs," as applied to the medicine, in and of themselves indicate that the medicine is made from figs. The circuit court of appeals for the sixth circuit said:

"It is manifest that the term 'Syrup of Figs' used to describe a medicinal preparation has a distinct and definite meaning, namely, a combination of sugar and the juice of the fig and possibly other ingredients, *in which, however, the medicinal property of the fig is the active and chief element.*" (73 Fed R., 815.)

This is the plain common sense view to be taken of those words. If any evidence be needed for so simple a proposition, it will be found in the record. (See testimony of Harry X. Gray, p. 389; of Henry E. Hall, pp. 391-94; of James Madison Quay, 398-99; of Joseph D. Grant, p. 422; and A. Cheesebrough, pp. 425-26; of W. P. Redington, pp. 235, 238, 241; and of J. A. Bright, pp. 530-31.)

It is conceded that the appellee's medicine is not a

syrup of figs. In deciding the case at bar Judge Gilbert said:

"The appellee's medicinal preparation is not a syrup of figs. It is not made from figs, and the quantity of figs used in its preparation is so small that it must be conceded to have little, if any, perceptible effect either in promoting the pleasant taste or otherwise." (102 Fed. R., 337.)

It is shown by the testimony that the medicine contains but a fraction of one per cent. of fig juice, and that this infinitesimal quantity has no effect whatever on the compound either by way of promoting the pleasant taste or adding any medicinal virtue.

Judge Taft said in the Stearns case, 73 Fed. Rep., 816:

"*Just a suspicion of fig juice* has been put into the preparation, not for the purpose of changing its medicinal character or even its flavor, but simply to give a weak support to the statement that the article sold is syrup of figs. This is a fraud upon the public."

In view of these facts, we submit that the name "Syrup of Figs" is in and of itself a false assertion, a deceptive term, and a fraud upon the public. This evident intent to deceive is accentuated by the pictures on the labels consisting of fig branches bearing figs, and of young ladies holding figs in their hands. Plainly the idea was

to convey the impression that the medicine was made from figs.

Again, the new label says that this medicine

"Presents in the most acceptable form the medicinal laxative principles of plants known to act most beneficially to cleanse the system," etc.

What plants are referred to? The only representation of anything in the shape of a plant on the label is the fig branch. There is no statement on this label that the active principle of the medicine is senna. The public is left to infer that the active principle is figs.

And still further, the new label proclaims that the medicine will *permanently overcome habitual constipation. This is a direct and positive falsehood.* There is no medicine known to science that will permanently overcome habitual constipation. See testimony of Dr. Kerr (Rec., p. 568) and Dr. Dodge (Id., 556.)

These physicians were called for the purpose of showing the falsity of such a contention and they testify squarely to the fact. They were not contradicted, nor was there any attempt at contradiction. Therefore, as the evidence stands, it is an established fact of record that there is no medicine which will permanently overcome habitual constipation, and, consequently, this statement on the new label is a falsehood.

And finally, it is stated on the label that the juice of figs in the composition is *to promote the pleasant taste.* It will be observed that this language is printed in very small and almost illegible type. Unless a person has unusually good eye sight, he would need the aid of a magnifying glass to decipher it. It is scarcely possible that the purchaser would ever notice it, and even if he did, it is not likely that it would change the impression which had already been produced by the more striking statements and representations on the label tending to induce the belief that the medicine was made from figs.

But even this statement itself is a falsehood. It is not true that the juice of figs in the combination promotes the pleasant taste. There is such an infinitesimal amount of fig juice present that it can neither promote the pleasant taste nor have any other effect. *There is less than one-tenth of one per cent of fig juice in the medicine* (see finding of court in *California Fig Syrup Co.* vs. *Stearns*, 73 Fed. Rep., 813, and also Record, 95-6).

In one hundred gallons of the medicine there would be one-tenth of a gallon of fig juice, and in one gallon, one thousandth. Calling a spoonful fifty drops, which is excessive in actual practice, there would be in a spoonful of this medicine (an ordinary dose) just *one-twentieth of a drop* of fig juice; so that a person taking three

doses a day would at the end of one week have accumulated one drop of the juice in his system. *One drop a week* is decidedly homeopathic in quantity, and we submit that such an infinitesimal dose can have no effect either medicinally or by way of promoting the taste. It cannot be detected. The medicine would be precisely the same both as to effect and as to taste if there were no fig juice in it at all. This is admitted by Mr. Queen, the man who manufactures the medicine. (See Record, pp. 98-99-100-1.)

As was said by Judge Taft, there is just a *suspicion of fig juice* in the preparation, which was put into it, "not for the purpose of changing its medicinal character or even its flavor, but simply to give a weak support to the statement that the article sold is syrup of figs." (73 Fed. R., 816.)

And Judge Gilbert says in the case at bar, "The appellee's medicinal preparation is not a syrup of figs. It is not made from figs, and the quantity of figs used in its preparation is so small that it must be conceded to have little, if any, perceptible effect either in promoting the pleasant taste or otherwise." (Record, 642.)

Thus we see, that according to Mr. Queen, the manufacturer of the medicine, and according to the findings of the court of appeals of the sixth circuit, through

Judge Taft, and the findings of the court of appeals of the ninth circuit, through Judge Gilbert, there is but an infinitesimal amount of fig juice in this medicine, and the same has no effect whatever either medicinally or by way of promoting the pleasant taste. To put it in the exact language of Judge Gilbert, "the quantity of figs used in its preparation is so small that it must be conceded to have little, if any, perceptible effect either in promoting the pleasant taste or otherwise." It follows conclusively, therefore, in our judgment, that the statement on the new label relied upon by appellee to repel the charge of fraud, viz., the statement that the juice of the fig is put in to promote the pleasant taste, is itself a false statement. In this new label, therefore, we have the following distinct misrepresentations:

First.—The designation of the medicine as a syrup of figs; whereas, according to Judge Gilbert, it is not a syrup of figs nor made from figs.

Second.—The statement that the medicine overcomes habitual constipation; whereas, according to the medical testimony, that is impossible.

Third.—The statement that the juice of figs in the medicine is to promote the pleasant taste; whereas, according to Mr. Queen, the manufacturer of the medicine,

and according to Judge Gilbert in his decision, as well as according to the decisions of the eastern circuits, the small quantity of fig juice in the medicine does not promote the pleasant taste nor does it add anything whatever to the medicine.

And furthermore the new label has pictures of fig branches and young ladies holding in their hands branches bearing figs, all tending to create the impression that the medicine contains figs as an essential ingredient.

The answer which the court of appeals in the case at bar made to this obvious proposition is, (1). That the term "Syrup of Figs" is not deceptive, because a person who takes such a medicine must necessarily know that its virtues are not due to fig juice, and (2), If he did not know the fact, then there is to be found on the label a distinct intimation to the contrary which would correct the false impression.

The exact language used by the learned judge who rendered the opinion is as follows:

"We do not think the name 'Syrup of Figs' as applied to the appellee's preparation is in itself calculated to mislead or deceive the public to any material extent. Any one who knows enough to take medicine when he is ill, must know that a liquid medicine to be taken in small

doses as a laxative, would be worthless for the purpose intended if it consisted of nothing more than a syrup or decoction of figs. There is in the form in which the medicine is presented, the purpose for which it is used, and the size of the dose which is prescribed, sufficient to charge him with notice that the medicine contains something more than the preparation of figs. And if, indeed, he be so uninformed and ignorant that the name 'Syrup of Figs' alone conveys to him the impression that the compound is made of figs, there may be found in the carton a distinct intimation to the contrary. It is there declared that the remedy presents in the most acceptable form the medicinal laxative principles of plants known to act beneficially and that the juice of the fig in the combination is only to promote the pleasant taste."

Regarding the first reason above advanced, we think it sufficiently answered by Judge Taft. Said he, in rendering the decision in the Stearns case (73 Fed. Rep., 817):

"The argument for complainant is that because fig juice or syrup has no laxative property everybody ought to understand that when the term is used to designate a laxative medicine, it must have a fanciful meaning. But the fact is admitted that the public believes that fig juice or syrup has laxative medicinal properties. It is to them that the complainant seeks to sell its preparation, and it is with respect to their knowledge and impressions that the character, whether descriptive or fanciful, of the term used, is to be determined."

And Judge Colt said in the Putnum case (66 Fed. Rep., 751):

"It may be true as a scientific fact known to physicians and pharmacists that the syrup of figs has little or no laxative property; but this is not the belief of the general public. They purchase this preparation on the faith that it is a laxative compound made from the fruit of the fig, which is false."

We think this reasoning is unanswerable. The medicine is bought by the public at large upon the strength of the name, not on the prescription of physicians. Such purchasers have no technical knowledge of medicine, and we submit that it is not true that they would know that it would be worthless for the purpose intended if it consisted of nothing more than a syrup or decoction of figs. On the contrary, they would naturally think otherwise, because of the popular impression that figs are laxative. A physician, a pharmacist, or a professor of chemistry, might think as suggested by the learned judge of the court of appeals, but we submit that a hod carrier, a servant girl, or a bootblack might not.

As to the second answer advanced by the court of appeals in this case, viz, that there is a distinct intimation upon appellee's labels that the medicinal properties

of its medicine is not due to figs, but that the juice of the fig is only to promote the pleasant taste, we desire to reiterate what we have already said: *that this statement is in itself a false one, because the juice of the fig does not promote the pleasant taste*, for Judge Gilbert says in his opinion that the quantity used "is so small that it must be conceded to have little, if any, perceptible effect, either in promoting the pleasant taste or otherwise." And furthermore, on this point we desire to again say that, even if this statement were true, it could not in the nature of things correct the false impression conveyed by other and more prominent representations on the labels due to the name of the article and the representations of fig branches bearing the ripe fruit. These representations, added to the popular impression that figs are laxative, necessarily convey to the mind of the public at large that the laxative principle of this medicine is due to figs.

In this connection it was urged by the appellee's counsel in the court of appeals, and will doubtless be urged by him here, that the appellee has published to the world the fact that the basis of its medicine is senna. These advertisements appear to have been inserted mostly in medical journals. It is scarcely possible that the public at large would ever see or read such journals, as they are

read mostly by medical men. But irrespective of that, the fact still remains that the *labels* of the appellee, by which its medicine is sold, do not contain that statement. It is by the labels that the rights of appellee must be gauged, and not by the advertised statements in medical journals disconnected from the labels and the sale of the medicine itself. If a person is selling an article under a fraudulent name, trade-mark, and label, and is enabled to make his sales by reason of such fraud connected directly with the sale of the medicine itself, he cannot be relieved from the charge of fraud in a court of equity by pointing to the fact that he has advertised in certain medical journals of limited circulation statements tending to contradict the false impression conveyed by the name, trade-mark and labels of his article. The fraud inheres in the name, trade-mark, and labels themselves as directly connected with the sale of the medicine.

We believe the record shows that the appellee also inserted advertisements in journals and papers other than medical, but, if we remember aright, in those advertisements there was no statement that the active principle of the medicine was senna, except in one or two instances.

Taking all these things together, we assert, without fear of successful contradiction that this new label is

fraudulent and deceptive under the decisions rendered by this and other courts. They are so numerous that they will fill a book; but we venture to refer to two which are so aptly in point that they would seem amply sufficient for a correct disposition of the case. We refer to *Brown Chemical Company* vs. *Meyer*, 139 U. S., 540, and *Schmidt* vs. *Bricg*, 100 Cal., 673.

In the first of these cases it was held by this court that the name "Brown's Iron Bitters" could not be lawfully appropriated as a trade-mark because it was so far indicative of the ingredients, characteristics, and purposes of the medicine as to be incapable of lawful appropriation by way of trade-mark. In other words, the name was *ex vi termini* descriptive. If the defendant in that case had asserted that the name was not descriptive because the bitters contained no iron, who is there so little versed in law as not to know what would have been the ruling?

The second case quoted, *Schmidt* vs. *Bricg*, 100 Cal., 673, involved the asserted right of appropriating the words "Sarsaparilla and Iron" as applied to a drink. Following the decision of this court in *Brown Chemical Co.* vs. *Meyer*, above quoted, the Supreme Court of California held that the words "Sarsaparilla and Iron" were in and of themselves so far descriptive that they could

not be appropriated as a trade-mark. In answer to that contention the plaintiff in the case argued that his beverage was not made from sarsaparilla and iron, and that it contained such an infinitesimal quantity of sarsaparilla and iron that it did not give to the compound any distinctive characteristic, and, therefore, the name was purely fanciful. This is the precise argument put forth by the California Fig Syrup Company; but the California Supreme Court was not impressed with the argument in that regard and held it to be unsound. In rendering their decision they said:

"But it is claimed by respondents (plaintiffs below) that the words 'Sarsaparilla and Iron' do not, in fact, indicate the character, kind, or quality of their beverage; that it is not a composition of sarsaparilla and iron, but a solution of various substances; that it contains only a small quantity of iron, and the name was given to the beverage only as a name by which it might be known, without in any way being descriptive; but it is sufficient to say in answer to this claim that the name given to the article is either generic, or it is of such a character that it can as well be applied to defendants' beverage as to the plaintiffs."

This clearly expresses the established law on the subject and is based on the leading case of *Manhattan Medicine Co.* vs. *Wood* (108 U. S., 218). Others of similar import are *The Leather Cloth Case* (4 De Gex J. & S., 137;

and 11 H. of L. Cas., 523), *Clotworthy* vs. *Schepp* (42 Fed. R., 62), *Alden* vs. *Gross* (25 Mo. App., 123), *Connell* vs. *Reed* (128 Mass., 477), *Siegert* vs. *Abbott* (61 Md., 276), *Seabury* vs. *Grosvenor* (14 Blatchf., 262), *Krauss* vs. *Peebles* (58 Fed. R., 585), *Mfg. Co.* vs. *Beeshore* (59 Fed. R., 572), *Fetridge* vs. *Wells* (13 How. Pr., 385), *Phalon* vs. *Wright* (5 Phila., 464), *Prince* vs. *Paint Co.* (135 N. Y., 24).

We do not need to go far to ascertain the reason why the California Fig Syrup Co. desires to convey the impression to the public that its medicine is composed of figs, or at least contains a substantial proportion of fig juice. The record on this subject is clear.

It is a known fact that there is a popular impression amongst people at large that figs have laxative properties. This impression has been known to exist from time immemorial, and is so firmly fixed that this court may possibly take judicial notice of it. But whether this court would take such notice of it or not, the testimony in the case proves it conclusively, for witness after witness testified to the existence of such popular impression. As a matter of fact this popular theory is a false one. Fig juice is not laxative. The medical men tell us that the seed and the skin of the fig may possibly be slightly laxative, when eaten in large quantities, just as

bran or oatmeal, by reason of the mechanical or grinding action upon the coating of the intestines. Even that is disputed by some medical authorities. But however that may be, it is conceded by all medical men that fig juice is not laxative. The appellee puts in his medicine no part of the seed or the skin of the fig, but merely an infinitesimal part of its non-laxative juice. The public, however, does not know this. They think that fig juice is laxative, and when they hear the term "Syrup of Figs" used, as applied to a laxative medicine, they naturally conclude that the medicine is made from fig juice, and that it has laxative properties. It was for the purpose of trading upon this popular, but false impression, that Mr. Queen adopted the name "Syrup of Figs." There is no question of this. There can be no other explanation.

In the statement of facts made by Judge Taft in the Stearns case (73 Fed. Rep., 813), we find the following:

"The popular impression that figs are laxative by reason of any medicinal element contained in them is erroneous. Their laxative effect, when eaten in some quantities, is caused by the physical action of the seeds and skin upon the bowels. There is practically no laxative property in the juice of the fig any different from the juice of any other fruit. It has no effect whatever unless taken in quantities as great as that of a pint or a quart."

And Judge Swan, in the same case in the lower court said (67 Fed. R., 1014):

"There can be no doubt, therefore, either that the complainant's preparation is not in fact compounded of the juice of the fig, but its principle is senna, or that its name was adopted and is used for the purpose of trading upon the popular fallacy that the juice of the fig in medicinal doses is an effectual remedy for constipation—an impression which is admitted to be without foundation —or that the ordinary purchaser buys the compound as and for the fruit remedy which it is advertised and asserted to be."

The basis of appellee's medicine is the well-known drug called *senna*, which has highly laxative properties. With this Mr. Queen compounds certain aromatic and saccharine substances, which he in his testimony bunches together under the nebulous term "aromatic carminatives." In this way he has produced a laxative medicine, whose basis is *senna*, and has called it by the deceptive term "Syrup of Figs" for the purpose of trading upon the popular but erroneous impression of the public that figs are laxative. All the indicia of the labels tend to show this. The name "Syrup of Figs," the name of the company, "California Fig Syrup Company," the picture of the young lady holding up a fig branch with ripe figs thereon, all support our theory. Mr. Queen could have had no other motive in view than that which

we attribute to him. His medicine could more properly be termed a syrup of senna. By no process of honest reasoning can it be called a syrup of figs.

Judge Colt says: "The compound is not a syrup of figs. It might more properly be termed a syrup of senna, etc." (66 Fed R., 750.)

Judge Taft says: "Just a suspicion of fig juice has been put into the preparation." (73 Fed. R., 816.)

Judge Gilbert says that this medicine "Is not a syrup of figs. It is not made from figs." (102 Fed. R., 337.)

As further showing the intention of appellee in this regard we again refer to the testimony of George Alt (Record, 326-346-8-9, 250-1, 356-7) who avers that he was one of the incorporators of the California Fig Syrup Co. and president thereof from June, 1882, to October, 1883; that he personally manufactured the medicine in Nevada, under the direction of Mr. Queen, for nearly two years, and was thoroughly familiar with the formula; that no figs whatever were used in the medicine, but Mr. Queen delivered to him an old gunny-sack full of figs and instructed him to expose them to view in the factory, so that the public would get the impression that figs were actually used, and in accordance with these orders he did expose the figs to public view.

In view of all these facts, it seems impossible to avoid the conclusion that this name is in and of itself a fraudulent representation.

III.

QUESTION OF UNFAIR COMPETITION IN TRADE.

The lower court erred in holding that there had been unfair competition in trade by reason of simulated labels and wrappers.

The doctrine of unfair competition in trade is that no one shall be permitted to dress his goods in such shape, form, and appearance as to enable him to sell and pass them off as and for the goods of another. Consequently, the question to be determined in such cases is the similarity between the labels. If the labels of the defendant are so similar in form and appearance to those of the plaintiff as to create confusion in the market, so that by the use of these simulated labels the defendant is enabled to sell his goods to which they are attached as and for the goods of the other manufacturer, then there is unfair competition in trade. Or, to put it in other words, there is in such case an infringement of the label. The question depends entirely upon the similarity of the labels and the possibility or probability that the one will be taken for the other.

Of course, if the labels are so dissimilar that they are readily distinguishable and the purchaser will not take the one for the other, then there is no unfair competition, no infringement. The question is purely one of fact.

In the case at bar there is no showing that any one has ever been actually deceived by the appellant's labels. Certainly, Clinton E. Worden & Co., the manufacturers, have never deceived any one, because the goods were made by them on orders from retail druggists who knew that they were not purchasing the appellee's article.

Nor was any actual deception shown to have been perpetrated by the other defendants, the retail druggists, who sold the medicine. The evidence shows that they kept in stock not only the article put up by Worden, but also that of the appellee, and that when a purchaser wanted "Syrup of Figs," he was given his choice to take either the one or the other. If he preferred the appellee's article, he took that. If he preferred Worden's, then he took that; but in no case did these druggists sell Worden's article as and for that of the appellee. On this point the appellee is bound by the testimony which it produced in its own behalf. Two of the retail druggists, defendants herein, were called by the appellee as witnesses, and they both testified as above stated.

J. A. Bright, the first one, testified on page 525 *et seq.* and 535 *et. seq.*, that he kept both articles in stock; that sometimes a purchaser called for one and sometimes for the other, and in each case received what he called for; that he never tried to pass off the one for the other; that he was entirely fair, open, and above board with his customers; that he could truthfully say that he did not deceive his customers by trying to pass off one for the other.

T. F. Bacon testified at pages 544 and 546 substantially to the same effect regarding the sales made by him, showing that he never tried to pass off the Worden syrup as that of the appellee; that he never deceived any one in that regard; that none of his customers who bought the Worden syrup were deceived into buying it or did buy it as and for that of the appellee, but that it was a matter of choice with them as to which one of these two articles they would buy.

From the foregoing it is perfectly apparent that the Worden "Syrup of Figs" was sold openly, fairly, and above-board in the usual and ordinary course of business, and was never passed off for the syrup of the appellee. In other words, there was no *actual* deception as a matter of fact. Therefore, the only question for consideration is the probability that the Worden label could be

used by unscrupulous druggists to deceive their customers into thinking that it was the genuine. This question must be determined by a comparison of the labels themselves. Copies of the labels are attached to the record in the shape of a folder opposite page 634. The defendants have used three separate styles of labels marked on the folder as Complainant's Exhibits "I," "D," and "U."

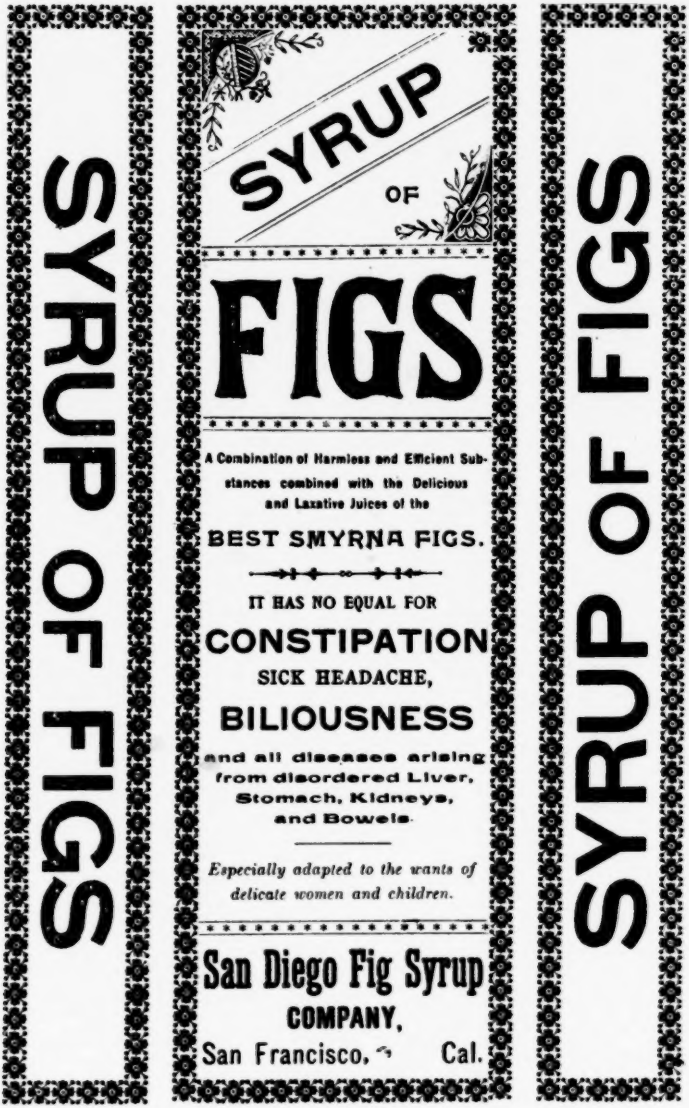
Concerning Exhibit "I," there certainly can be no question. It is so entirely dissimilar in every respect from the label of the appellee that no one having even the slightest intelligence could be deceived thereby. It is reproduced on the folder opposite page 634 of the Record. A mere glance at it is sufficient proof of this assertion.

The next label of the appellants is represented by the Complainant's Exhibit "U," likewise reproduced on said folder. Here again we find an entire dissimilarity in form and appearance from that of the appellee, such dissimilarity, in fact, as would prevent the said labels from being passed off as that of the appellee. The title of the medicine on this label, Exhibit "U," is "California Fig Syrup." While it is true that the appellee has no title to the term "California Fig Syrup," it is barely possible that some unusually ignorant purchaser might be led to suppose that the said Exhibit "U" was the label of the

appellee, from the fact that the name of the appellee as a corporation is "The California Fig Syrup Company." This is a very vague possibility, and we do not believe it would ever occur, but in order to show the fairness of Clinton E. Worden & Co., we discontinued the use of the label, Exhibit "U," and agreed never to use it again, *even before any injunction was granted.* The facts attending the use of Exhibit "U," are, that those labels were designed by an employe of the firm, and a very limited number of them sold, only one gross, before Mr. Worden was made aware of the fact; but when his attention was called to it, he ordered their immediate discontinuance, because they contained the words "California Fig Syrup." While he contended, and does now contend, that he is entitled to use the words "Fig Syrup," he did not think he had a right to prefix it with the word "California" and call it "California Fig Syrup," thinking that that might be an interference with the rights of the appellee. (Record, 438, *et seq.*)

But whatever may be the facts, we discontinued the use of that label Exhibit "U," before an injunction was granted and do not intend to use it again, even though this case be decided in our favor. It is a matter of very small moment and not worth discussion. Only one gross was used and no more will ever be used. *De minimis lex non curat.*

Complainant's Exhibit "D."


SYRUP OF FIGS
SYRUP
OF
FIGS
A Combination of Harmless and Efficient Substances combined with the Delicious and Laxative Juices of the
BEST SMYRNA FIGS.
IT HAS NO EQUAL FOR
CONSTIPATION
SICK HEADACHE,
BILIOUSNESS
and all diseases arising from disordered Liver, Stomach, Kidneys, and Bowels.
Especially adapted to the wants of delicate women and children.
San Diego Fig Syrup
COMPANY,
San Francisco, Cal.
SYRUP OF FIGS

The principal label in controversy is represented by Complainant's Exhibit "D" attached to the folder in the record; that label we desire to use and claim a right to use. It is reproduced on the adjoining page. Its only similarity to the label of the appellee is in the use of the words "Syrup of Figs." If the court decides that the appellee cannot monopolize those words, then the use of them on the labels in question cannot be prohibited, unless the remainder of the label is so similar to that of the appellee as to cause confusion in the trade. A comparison of the said label, Exhibit "D," with the appellee's label, Complainant's Exhibit "A," shows clearly that there is such dissimilarity between the two that there is no likelihood that the one will be taken for the other. It would be a useless waste of time for us to point out the differences. The labels speak for themselves and the court can see whether they are similar or not. In order, however, that they may be conveniently compared we reproduce them side by side on the folder at end of this brief.

But even if there were such similarity between the labels of appellant and appellee as to entitle the appellee to an injunction on the score of unfair competition, the appellee is disentitled to any such relief by reason of its fraudulent representations and practices regarding its medicine heretofore adverted to when discussing the

question of trade-mark. If there be fraud on the part of a complainant, he is not entitled to protection for his label any more than for his trade-mark. In that respect trade-marks and labels stand on the same footing. It would be a waste of time to dwell on this subject of fraud any further, as we have already discussed it, and, therefore, we merely refer to the matter.

IV.

PRIOR ADJUDICATIONS.

There has been much litigation during past years concerning this name "Syrup of Figs." Some of the cases were in the eastern circuits and two in the ninth circuit.

The first decision rendered in the eastern circuits was that of *California Fig Syrup Company* vs. *Putnam* (66 Fed. Rep., 759), decided by Judge Colt in the circuit court for the district of Massachusetts on March 6, 1895. That case involved the asserted right to use the words "Syrup of Figs" as a trade-mark. There was no question concerning labels or unfair competition in trade. The sole point in issue was whether or not said words "Syrup of Figs" could be appropriated as a trade-mark. In deciding the case Judge Colt said:

"If this preparation is in fact a syrup of figs, the words are clearly descriptive, and not the proper subject

of a trade-mark. Upon this point the contention of the plaintiff is that its preparation is not a syrup of figs, since it contains only a very small percentage of the juice of the fig; that the laxative ingredient in it is senna; that while the fig in the form of fruit may have laxative properties arising from the seeds and skin, the fig in the form of a syrup is no more laxative than any other fruit syrup; that it follows from these facts that these words as applied to this compound are not descriptive, but purely fanciful, and therefore constitute a valid trade-mark. The evidence shows that the compound is not a syrup of figs. It might more properly be termed syrup of senna, if the words were intended to be descriptive of the article. But assuming that this is not a syrup of figs, we are met with the inquiry whether these words as applied to this preparation are not deceptive."

The learned judge then proceeds to reproduce in his opinion the familiar cut of the California Fig Syrup Company, consisting of a young lady holding a fig branch in her hand, and quotes from the label used in connection therewith. He then continues his opinion as follows:

"The popularity of this medicine arises from the belief in the minds of the ordinary purchaser that he is buying a laxative compound, the essential ingredient of which is the California fig, whereas, in fact, he is buying a medicine the active property of which is senna. The ethical principle on which the law of trade-marks is based will not permit of any such deception. It may be true, as a scientific fact known to physicians and pharmacists, that the syrup of figs has little or no laxative properties; but

this is not the belief of the general public. They purchase this preparation on the faith that it is a laxative compound made from the fruit of the fig, which is false. This is not an immaterial representation, the effect of which is harmless, but it is a representation which goes to the very essence of the plaintiff's right to a trademark in these words. The cases are numerous where the courts have refused to grant relief under these circumstances."

Many of the leading cases are then cited in the opinion, and copious quotations taken therefrom, upon the strength of which authorities the bill was dismissed.

An appeal was taken by the California Fig Syrup Co. in that case, to the circuit court of appeals, where the judgment was affirmed by Judges Putnum, Nelson, and Aldrich. The opinion is very short and reads as follows:

"Per CURIAM. We agree with the reasoning and the conclusions of the circuit court in this cause, but we do not wish to be understood to approve all the cases cited in this opinion. It is sufficient to refer to *Medicine Co.* vs. *Wood*, 108 U. S., 218, and to the underlying principles of *Church* vs. *Proctor*, 13 C. C. A., 426, 66 Fed., 240, decided by this court February 2, 1895, as supporting the line of reasoning found in that opinion. The decree of the circuit court is affirmed."

California Fig Syrup Company vs. *Putnum*, 69 Fed. Rep., 741.

The second case is that of *California Fig Syrup Company* vs. *Stearns*, 67 Fed. Rep., 1008, decided by District Judge Swan for the eastern district of Michigan. It is there said:

"It is apparent from these facts that if the equities of the parties are dependent upon the quantity of fig juice which enters into their respective preparations, they largely preponderate in favor of defendant. It is equally apparent that complainant makes and sells its wares to the public under the representation that the active and controlling ingredient is derived from the fig, while in fact, under its own proofs, the juice of that fruit has no medicinal value and is lacking in the potency required for a laxative. * * * * The relief prayed by complainant is in truth the privilege of selling its preparation of senna under the name of 'Fig Syrup.' Whatever the virtues or popularity of complainant's specific, there is no ground on which such relief can be granted."

Consequently, the bill was dismissed. The case was appealed to the circuit court of appeals, and will be found reported in 73 Fed. Rep., 813, where it was affirmed by Judges Taft, Lurton and Hammond. The opinion was rendered by Judge Taft, and amongst other things he says:

"It may be that no one had ever made a syrup of figs at the time that Queen selected the term to designate the preparation which he put upon the market. That is immaterial. It is entirely possible to describe something

by the use of common words which may never have had a commercial use, or which may never have been in fact made. * * * It is manifest that the term 'Syrup of Figs' used to describe the medical preparation, has a distinct and definite meaning, namely, a combination of sugar and the juice of the fig, and possibly other ingredients, in which, however, the medicinal property of the fig is the active and chief element. * * The term 'Syrup of Figs,' therefore, cannot be used as a trade-mark. * * But the second ground presented, and that upon which the court below rested its decision, prevents the complainant from having any relief at all. That ground is that the complainant has built up its business and made it valuable by an intentional deceit of the public. It has intended the public to understand that the preparation which it sells has, as an important medicinal agent in its composition, the juice of California figs. This has undoubtedly led the public into the purchase of the preparation. The statement is wholly untrue. Just a suspicion of fig juice has been put into the preparation, not for the purpose of changing its medicinal character, or even its flavor, but merely to give a weak support to the statement that the article sold is syrup of figs. This is a fraud upon the public. It is true it may be a harmless humbug to palm off upon the public as syrup of figs what is syrup of senna, but it is, nevertheless, of such a character that a court of equity will not encourage it by extending any relief to the person who seeks to protect a business which has grown out of, and is dependent upon, such deceit. It is well settled that if a person wishes his trade-mark property to be protected by a court of equity he must come into court with clean hands, and if it ap-

pears that the trade-mark for which he seeks protection is itself a misrepresentation to the public, and has acquired a value with the public by fraudulent misrepresentation in advertisements, all relief will be denied to him. This is the doctrine of the highest court of England, and no court has laid it down with any greater stringency than the Supreme Court of the United States. * * The argument for complainant is that, because fig juice or syrup has no laxative property, everybody ought to understand that when the term is used to designate a laxative medicine it must have only a fanciful meaning. But the fact is admitted that the public believes that fig juice or syrup has laxative medicinal properties. It is to them that the complainant seeks to sell its preparation, and it is with respect to their knowledge and impressions that the character, whether descriptive or fanciful, of the term used, is to be determined. Exactly this question raised against the same complainant was considered by the circuit court for the district of Massachusetts (*Syrup Co.* vs. *Putnam*, 66 Fed., 750), and relief was denied by Judge Colt to the complainant on the ground that its use of the term 'Syrup of Figs' was a misrepresentation to the public, and a fraud upon it. The case was carried to the court of appeals, and affirmed upon the opinion of the circuit judge."

We thus see that in two circuit courts and in two circuit courts of appeal, and by eight different judges, the views which we have advanced concerning this trade-mark have been sustained.

The effect of these decisions was sought in the lower

court to be counteracted by the case of *California Fig Syrup Company* vs. *Improved Fig Syrup Co.* in the ninth circuit. The decision of the lower court in that case is reported in 51 Fed. Rep., 296, and was rendered by His Honor Judge McKenna while circuit judge. That case came up on demurrer to the bill and motion for a preliminary injunction, and was heard on affidavits. It appeared that the defendants, some of whom had been formerly associated with the California Syrup Co., had formed a corporation called the "Improved Fig Syrup Co.," and had adopted a label for its goods which, according to the opinion of Judge McKenna, was "identical in form, size and in device," with that of the complainant. The relief granted in that case was distinctly based on the ground of unfair competition in trade, and not on the ground of trade-mark. *Judge McKenna did not hold or decide that the words "Syrup of Figs" were a lawful trade-mark.* The question of legality of such a trade-mark was not passed on. It was utterly immaterial on that motion whether the words were descriptive or not, and there was no showing that they were fraudulently used so as to disentitle them to protection. In rendering his decision Judge McKenna said:

"But respondent urges that the words 'Syrup of Figs'

are descriptive and that complainant deceives when it uses them to designate its compound. *The deceit does not appear on the face of the bill, and it is unimportant if they are descriptive.* The question is now, not whether complainant has the exclusive right to use the words 'Syrup of Figs' or 'Fig Syrup,' but it is whether respondent has, by use of them and other words, and by the other limitations alleged and exhibited, so far imitated the form of complainant's device and description to represent its goods and appropriate its reputation and trade. The *gravamen* of the action is the simulation of complainant's devices and the deception of purchasers."

Consequently, the demurrer was overruled and the preliminary injunction granted. It thus distinctly appears that in that case *Judge McKenna did not decide that the words "Syrup of Figs" were a legitimate trade-mark*, but merely that the labels adopted by the defendant, being identical in form, size and device with those of the complainant, constituted unfair competition in trade. The question of fraud was not in issue, according to the opinion, and was not passed on, and we do not see how any different decision could have been rendered in that case on the record there presented.

That case went to the court of appeals and was affirmed. It is reported in 54 Fed. Rep. at page 175, the decision being rendered by his Honor Judge Beatty. The appeal was taken from the order of the lower court

granting a preliminary injunction, and that order was affirmed. So far as the question of deception and fraud is concerned by the use of the words "Syrup of Figs," the court made no adjudication, for the simple reason that the fraud and deception were not made to appear. Said Judge Beatty in rendering his decision:

"It is next urged that the appellee has no standing in a court of equity, because in the representation it has made concerning its medicine it has practiced deceit and fraud upon the public. *If this were clearly established by the evidence, it would be ground for reversal.* Trade-marks which are based on misrepresentations and deceit, and especially such as are intended to deceive and defraud the public into the purchase of articles for what they are not—into the belief they are valuable, when deleterious—will not be protected by the courts. There is too much reason for the assertion that 'there is not a thing that we eat or drink or wear which is pure or genuine.' To protect a dishonest manufacturer in a fraudulent and deceptive trade-mark would be simply to aid him in fraud; to add to his unlawful gain by assisting him in palming off upon the public his worthless wares as valuable, and thus discourage, injure and bankrupt the honest dealer, as well as to impose upon the public. Upon a proposition so plain discussion or the citation of authorities would seem unnecessary, but we may in this connection refer to *Medicine Co.* vs. *Wood*, 108 U. S., 218, and the cases therein cited. While we agree with appellants as to the doctrine, we are not satisfied from

the evidence that the appellee has attempted to practice any fraud or impose upon and damage the public."

The conclusion was eminently proper in that case, because the demurrer to the bill admitted the truth of its allegations, and there was certainly no showing in the bill that the words were used deceptively. Under such circumstances the court could not possibly have held otherwise; but if the case had been brought up upon full proofs showing the deceptive character of the words, as has been done in the case at bar, there would probably have been a different decision. The weakness of the appellant in that case consisted in taking the case up on a motion for an injunction before proofs on final hearing had been submitted.

That the sole point decided by the court of appeals in that case related to unfair competition in trade is manifest from the following part of his decision:

"As we construe the restraining order of the court below, it simply excludes the use by appellant of trademarks, bottles, wrappers, and devices used in offering their preparation to the public similar to those applied by the appellee to its preparation for a similar use and purpose. Appellants are not restrained from making their medicine, but from offering for sale or selling it under such or any circumstances, declarations, or representations that it may be taken as the preparation made and offered to the public by the appellee. * * *

We think the facts before the lower court clearly justified the conclusion as reached, and its order and judgment, so far made, are affirmed."

It is apparent from the foregoing that the court passed on nothing else than the question of unfair competition in trade caused by simulated labels and wrappers, and in so passing upon that question did not consider the question of fraud and deception, the question which we are now raising, because that question was not involved in that case. Therefore, the decision of the court of appeals in that case is not in conflict with the views heretofore advanced by us nor with the decisions of the eastern circuits.

There is, however, one portion of the decision in that case which the appellee relies upon as an adjudication that the words "Syrup of Figs" are a valid trade-mark. Such a question as that, however, was not involved in the case, and any remarks made thereon by the learned judge who wrote the decision is mere *dictum* and not binding on us, who were not parties to that case and had no opportunity to be heard. The portion of the decision referred to begins on page 178 of the report and reads as follows:

"The phrase 'Syrup of Figs' is in no sense a generic one. It is not a name of a natural product, or of a class

of natural products. If such an article exists, it must be the result of a manufacturing process. So far as we are advised the name never existed, nor was it applied to any natural or artificial product, until formulated by appellee of words of no prior association, and by it used to designate its preparation. Even if such medicine were made entirely of figs, it is still a new name, applied to a manufactured, and not a natural, product; hence, indicates rather its origin, than its quality or even its name. It is not, however, claimed by the appellee that its preparation is a product of figs alone, but that it is produced from a combination of the juice of figs with other plants. In this light the phrase is not 'merely descriptive of an article of trade, of its qualities, ingredients, or characteristics.'"

If by this language the learned judge meant to hold that the words "Syrup of Figs" were not descriptive and were, therefore, the subject of a lawful trade-mark, we submit that it was mere *dictum*. No such question was necessarily involved on that hearing. Judge McKenna expressly held in the lower court that it was utterly immaterial, for the purposes of that case, whether the words were descriptive or not, because the sole ground of relief was unfair competition in trade. The court of appeals affirmed the judgment in that case, and such affirmance did not extend to anything which was not decided in the lower court.

In the case of *California Fig Syrup Co.* vs. *Putnam*, 66 Fed. Rep., 754, the court says:

"The plaintiff relies on the decisions of the circuit court for the northern district of California, and the circuit court of appeals for the ninth circuit in a case brought by it against the Improved Fig Syrup Company (51 Fed., 296, and 4 C. C. A., 264, 54 Fed., 175.) That case, however, was only heard on motion for preliminary injunction; it also presented a different state of facts."

The "different state of facts" referred to by Judge Colt included an absence of any showing of fraudulent representations by the appellee as to the constituents of its medicine. Had such showing been made before the court of appeals in the Improved Fig Syrup case, then the facts of the two cases would have been more nearly alike, and the two decisions would have been in conflict. The different state of facts, however, as shown by Judge Colt, shows that the two decisions are not conflicting.

The decision of the court in the Improved Fig Syrup case was also examined by Judge Swan in the case of *California Fig Syrup Co.* vs. *Stearns*, 67 Fed. Rep., 1015. He takes precisely the same view as we have heretofore advanced, viz., that the court rendered its decision in the Improved Fig Syrup case on the ground of unfair competition in trade. After showing that by copious quota-

tions from the opinion, the learned judge proceeds as follows:

"It is true that the court of appeals discusses at some length the character of complainant's trade-mark; yet with all deference to the opinion of the learned court, it would seem from its concluding paragraph, quoted *supra*, that its expression upon this point (i. e., trade-mark proper), was not necessary to the decision of the case presented, and that the true ground for the relief granted was the manifest equity of complainant to have the defendant restrained from unfair trade independent of the question arising upon the validity of the trade-mark in controversy."

We submit, therefore, that the decision rendered by his Honor Judge McKenna in the Improved Fig Syrup case and affirmed on the appeal, is not in conflict with the eastern decisions.

The last decision is that rendered in the case at bar, which is squarely in conflict with the eastern decisions. It is for this court to say which is correct.

V.

THE MATTER OF ACCOUNTING.

That portion of the decree which awards an accounting is erroneous and should be reversed.

The portion of the said decree referred to reads as follows:

"And it is further ordered, adjudged and decreed that the complainants do have and recover of and from the said defendants * * * * * * the *profits, gains and advantages* which said defendants or either of them have received or made or which have arisen or accrued to them or either of them from the infringement of the rights of complainant by using said name and by the making, using and selling, or the making, using or selling of said liquid laxative medicine, having placed thereon the name 'Syrup of Figs' or 'Fig Syrup,' or any other name in imitation of complainant's said medicine."

There is in the decree no award of *damages*, nor any accounting thereof, merely an award of *profits*.

Such a decree as this is erroneous. Possibly the learned counsel, in drafting the decree, had in mind the rule of law which obtains in patent cases, to wit, that a successful complainant is entitled to recover in equity the profits realized by the defendants from the infringement as well as the damages sustained by the complainant, and he must have thought that by analogy such a rule obtains in a trade-mark case. But in this he errs. There is no such provision.

The provision in relation to patents is purely statutory. By section 4919 of the Revised Statutes it is provided that a patentee may in an action on the case recover damages for the infringement of his patent, and section 4921 provides that a patentee in a suit in equity

is entitled to recover both damages and profits, that is to say, the damages suffered by him and the profits realized by the defendants. These provisions are purely statutory and relate only to patents.

In regard to trade-marks there is no such statutory provision. The complainant sues on his common-law right, bringing his suit in the federal court on the ground of diverse citizenship of the parties. In such case, all that he can recover, whether he sue at law or in equity, is the damages he has suffered, and those must be the actual damages. Now there are various modes for measuring those damages, dependent upon the facts of each particular case. Lost sales and enforced reduction in selling prices, and matters of that kind are generally resorted to, and furnish more or less reliable standards for measuring a plaintiff's damages. If it can be shown by him that the infringing competition resulted in a loss of sales by him, and if he can show the extent of such loss of sales and the profits he would have made thereon, or if he can show that he was forced to reduce his selling prices and thereby lost on the goods which he actually sold, he thereby furnishes some reliable basis for measuring his damages. But in all these cases it is the actual *damage* suffered by him which he recovers.

The defendant's profits are not necessarily the measure of plaintiff's damages, because it does not follow that the plaintiff would have made those profits if the defendant had not infringed. This is too palpable to admit of discussion.

Now the decree is that the complainant recover "the profits, gains and advantages" which the defendants "have received or made, or which have arisen or accrued to them * * * from the infringement."

All that the complainant would have to do on the accounting would be to show the amount of those "profits gains, and advantages," and thereupon he would be entitled to judgment therefor, without showing that those profits were the measure of his damages. In other words, he would recover the defendant's profits *as such*, without regard to his own damages. His actual damages may have been less than the defendant's profits, or he may have suffered no damages at all, and yet under this decree he would be entitled to recover the defendant's profits, regardless of every other question. We submit that such a decree is erroneous.

Were this a patent case, the rule would be different, because the patent act expressly authorizes the recovery of defendant's profits. Being a trade-mark case, how-

ever, founded on a common-law right, the complainant is not entitled to recover the defendant's profits as such.

But, furthermore, there is another reason why this portion of the decree is erroneous. There is no allegation in the bill of complaint that the defendants have ever realized any profits from the infringement. There is an allegation that the complainant was damaged in the sum of ten thousand dollars by reason of the infringement, but there is no allegation that the defendants realized any profits. For aught that appears from the bill the defendants may have lost money by the infringement, and there is no proof that they made any profits. While that fact would not have prevented a recovery of complainant's damages, it certainly prevents any recovery of profits. Therefore it was clearly an error to enter a decree for profits. A complainant is supposed to state in his bill what he sues for, and if he maintains his case, he is entitled to a judgment accordingly; but he certainly is not entitled to a judgment for something that he does not sue for. That is the posture of affairs in this case. Complainant did not allege any profits; but, nevertheless, the court awarded him a decree for profits. It was just as much of an error to award him a decree for profits under such circumstances as it

would have been to have awarded him a decree quieting his title to real estate.

Were any authority needed for so simple a proposition, we would refer to 3 Robinson on patents, section 1106, and Walker on patents, section 579.

In the first citation it is said:

"A bill in equity, in actions for infringement, must disclose the substantial ground work of the case and contain averments covering every material fact, *the court having no authority to consider what is proved and not alleged*, or what is alleged and not suported by the evidence."

In the second citation, speaking of the necessary averments of a bill, the author says:

"And when profits are sought to be recovered, it (the bill) must plainly aver that profits were realized by the defendant on account of the stated infringement. This last allegation has heretofore been sometimes omitted from bills in patent cases, but the omission would always have been a fatal one, if the defendants had availed themselves of it. The necessity for such an allegation follows from the rule of patent law that, where a particular infringer made no profits from his infringement, no profits can be recovered from him, and from the rule of equity pleading, that every fact which is necessary to entitle a complainant to the relief for which he prays, must be distinctly and expressly averred in the stating part of his bill."

These citations refer to patent cases, but their application to the case in hand is sufficiently apparent.

The court of appeals declined to consider this point for the reason that there was no assignment of error covering the same. We think, however, that it is such a plain and palpable error that it can well be considered under the general rule that "the court at its option may notice a plain error not assigned." (Rule 2, court of appeals rules.) Certainly this court can consider it if it see fit.

In conclusion, we submit that the appellee failed to make out such a case as entitles him to any relief in a court of equity; and to recapitulate, we say:

1. *If the medicine in question contains an appreciable quantity of fig juice, then the same "Syrup of Figs" is so far descriptive that it cannot be appropriated as a lawful trade-mark.*

2. *If on the other hand the medicine contains no appreciable quantity of fig juice, then the name is ex proprio vigore deceptive.*

3. *But if the name alone is not sufficient as a basis for deception, then the pictures, illustrations, and advertisements in connection with the facts attending the adoption of the name clearly show fraudulent practices on*

the part of the appellee, such as will disentitle him to any relief in a court of equity.

4. *No case has been made out by appellee to entitle him to an injunction on the ground of unfair competition in trade by reason of simulated labels and wrappers, because the appellant's labels do not so clearly resemble those of the appellee as to constitute infringement.*

5. *It was error to award a decree for an accounting of profits because there was no allegation in the bill that profits had been realized, and because further, even if there had been any such allegation, they could not be recovered in a suit on a common law trade-mark.*

6. *The prior adjudications in the eastern circuits clearly establish the fact that the appellee was entitled to no relief, and those decisions are well founded in point of reason.*

We, therefore, respectfully ask that the decree in this case be reversed and the cause remanded to the circuit court of the United States for the Northern District of California, with instructions to dismiss the bill and enter a final decree in favor of the appellants for their costs.

JOHN H. MILLER,
PERCELL ROWE,
Counsel for Appellant.

Complainant's

Exhibit "A."

CALIFORNIA FIG SYRUP Co.
SAN FRANCISCO. CAL.

SYRUP OF FIGS

THIS EXCELLENT REMEDY PRESENTS IN THE

MOST ACCEPTABLE FORM

THE MEDICINALLY LAXATIVE PRINCIPLE OF PLANTS KNOWN TO ACT MOST GENTLY AND PERFECTUALLY; TO CLEANSE THE SYSTEM EFFECTUALLY; TO PERMANENTLY OVERCOME

HABITUAL CONSTIPATION

AND THE MANY ILLS DEPENDENT ON IT; TO DISPEL COLDS AND HEADACHES AND PREVENT FEVERS; TO ACT GENTLY YET PROMPTLY ON THE

KIDNEYS, LIVER AND BOWELS

THE JUICE OF FIGS IN THE COMBINATION IS TO PROMOTE THE PLEASANT TASTE

MANUFACTURED ONLY BY THE

CALIFORNIA FIG SYRUP Co

OF SAN FRANCISCO, CAL.

LOUISVILLE, KY. NEW YORK, N. Y.

PRICE, 50 CENTS.

REGISTERED IN PATENT OFFICE.

SYRUP OF FIGS is better than Pills, Oils, Salts and other disagreeable medicines, as it is more easily taken, more acceptable to the stomach, more gentle in its action, more beneficial in its effects, and because it acts without irritating or weakening the Kidneys, Liver and Bowels. Its efficacy and delicacy of flavor, are due to the medicinal and agreeable qualities of plants and aromatic carminatives, skillfully combined with pleasant liquids, among which may be mentioned the juice of figs. It is entirely free from every objectionable quality or substance, is adapted to young and old and therefore the best of family laxatives.

☞ FULL DIRECTIONS AND DESCRIPTION ON INSIDE WRAPPER.

FEIGEN SYRUP uebertrifft alle uebrigen Heilmittel, indem derselbe sowohl fuer Kinder wie fuer Erwachsene leicht einzunehmen ist, vom Magen leicht verdaut wird, und auf Nieren, Leber und Eingeweide angenehm und schnell wirkt, das System reinigt, Fieber und Kopfschmerzen vertreibt, Erkaeltungen hebt, so dass reines Blut, erfrischender Schlaf, Gesundheit und Kraft, natuerlicherweise folgen muessen. Derselbe ist besser als Oel, Salz, Pillen und andere bittere ekelhafte und abtreibende auf die Leber wirkende Arzneien, weil er die Organe, auf welche er wirkt, kraeftig, und ebenso heilsam ist fuer das Kind wie fuer die Mutter, fuer den Invaliden, Kranken, wie fuer den starken, robusten Mann, wenn billoes oder an Verstopfung leidend.

☞ GEBRAUCHSANWEISUNG UND BESCHREIBUNG INNERHALB DES UMSCHLAGS.

Complainant's Exhibit "D."

SYRUP OF FIGS

SYRUP OF FIGS

SYRUP OF FIGS

A Combination of Harmless and Efficient Substances combined with the Delicious and Laxative Juices of the

BEST SMYRNA FIGS.

IT HAS NO EQUAL FOR

CONSTIPATION

SICK HEADACHE,

BILIOUSNESS

and all diseases arising from disordered Liver, Stomach, Kidneys, and Bowels.

Especially adapted to the wants of delicate women and children.

San Diego Fig Syrup COMPANY,

San Francisco, Cal.

SYRUP OF FIGS